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United States Circuit Court of Appeals

FOR THE NINTH CIRCUIT.

No. 2314, OCTOBER TERM, 1913.

PACIFIC PHONOGRAPH CO., A CORPORATION,
Appellant,

vs.

SEARCHLIGHT HORN CO., A CORPORATION,
Appellee.

APPELLANT'S BRIEF.

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2. U. S. Patent, No. 748,969, of Jan. 5, 1904, to Melville (T., p. 307, Fig. 1)..... 23

3. U. S. Patent, No. 763,808, of June 28, 1904, to Sturges (T., p. 310, Figs. 1 and 2)..... 23

4. British Patent No. 22,273, of Nov. 5, 1901, to Runge (T., p. 341, Fig. 2)..... 23

5. French Patent No. 318,742, of Feb. 17, 1902, to Turpin (T., p. 380, Figs. 8-16)..... 23

6. French Patent No. 321,507, of May 28, 1902, to Runge (T., p. 395, Fig. 2)..... 24

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To imply as elements of a claim limitations not set forth therein for the purpose of limiting its scope, so that it may be accorded novelty is contrary to a well-settled rule of the Patent Law. The District Court in charging the jury, in the *Sherman, Clay & Co.*, action at law, committed this error, erroneously charging the jury that the horn of "the claims" of the Nielsen Patent had "substantially a bell-shape" and that "the strips must curve outwardly from the inner to the outer end, but the curve is more abrupt adjacent to the outer end". In *Coupe v. Royer*, 155 U. S., 565, 575-577, the Supreme Court reversed for just such an error. 29

There is nothing whatever in the claims of the Nielsen patent to warrant the charge of the District Court that the horn of the claims had "substantially a bell-shape and abruptly flaring outlet" or that "the strips must curve outwardly from the inner to the outer end, but the curve is more abrupt adjacent to the outer end." The decided cases show that this holding of the District Court was a clear error of law. 29

Stearns & Co. v. Russell, 85 Fed., 218, 224. 30

McCarty v. Railroad Co., 160 U. S., 110, 116. 30

Universal Co. v. Sonn et al., 154 Fed., 665, 668. 31

Merrill v. Yeomans, 94 U. S., 568, 573. 31

White v. Dunbar, 119 U. S., 47, 51. 32

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Claim 3 of the Nielsen Patent in suit was anticipated, in any view of the claim, by the patents of the prior art. Claims 1 and 2 are also anticipated unless those claims are limited, as they must be, by "strips of metal provided at their edges with longitudinal outwardly-directed flanges whereby * * * the body portion of the horn is provided on the outside thereof with longitudinally-arranged ribs." The principal references relied upon as anticipations, in the suit at bar, were not before the court either in the action at law or in the equity suit against Sherman, Clay & Co. 36

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As shown in Fig. 14 (T., p. 381), the horn (which is constructed in the same manner as the horn shown in Fig. 8, that is to say, of tapering strips of wood joined together at their edges and provided with longitudinal ribs of wood or metal, extending from one end to the other of the horn at the points where the strips are secured together), is a horn having a curved or bell-shape, that is to say, the precise shape of the horn shown in Fig. 1 of the Nielsen patent in suit 38

Since Turpin pointed out that horns for phonographs should be constructed of strips of wood instead of metal, or from strips of wood combined with strips of metal, having curved meeting-edges (Fig. 14) and longitudinal ribs upon the outside or inside of the horn, it involved no invention on Nielsen's part to construct the same horn, according to the same method, from strips of metal instead of strips of wood. The authorities clearly show that, in such cases, the mere substitution of material does not involve invention (see authorities cited, *infra*, pp. 72-73)..... 42

2. British patent No. 20,146 of September 15, 1902, to Villy (T., p. 349).....	42
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Fig. 8 of the Villy British patent shows the precise form of the tapering strips with curved sides, which the District Court held, and plaintiff's counsel contends, is the essence of Nielsen's alleged invention of the patent in suit. Nielsen merely made the strips of metal, while Villy stated that he made the strips of Fig. 8 "of paper, wood, linen, or other preferably flexible material" (T., p. 351, lines 5-6), which in this art included metal and all other known equivalent flexible materials (*supra*, pp. 22-24; *infra*, pp. 71-72)..... 43

The horn of Fig. 1 of the Nielsen patent in suit is nothing but the horn of Fig. 5 (T., p. 354) of the Villy patent, except that the ribs or ridges of the Nielsen horn consist of the two outwardly-directed flanges joined together..... 43

Defendant's Edison straight horn is clearly the horn of Fig. 5 of the Villy patent..... 45

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1. The construction of horns for phonographs from tapering strips of flexible material, having curved meeting-edges, was old in the prior art..... 64

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In other words, Hawthorne & Sheble made horns, of the shape and construction of the Nielsen horn, except as to the kind of seam employed, in precisely the manner shown in Fig. 2 of Gersdorff's United States patent No. 491,421 of February 7, 1893, for a funnel or horn (T., p. 258; <i>supra</i> , pp. 48-51).....	73
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"Time passes, memory fails, witnesses die, proof is lost, and the rights of individuals and of the public intervene" (Kittle v. Hall, 29 Fed., 511).....	80

Mr. Krabbe and Mr. Locke, testifying on behalf of the plaintiff, stated that both before and after Nielsen filed his application for the patent in suit, others were for years constantly making and selling, in this country, horns now claimed to infringe the patent (T., p. 192; and Transcript in No. 2306, pp. 46-48, 67-68, 80-81, 87-88) 81

Mr. Locke confirms the statement of Mr. Hawthorne with respect to what passed between them in 1906 with regard to the Nielsen patent (T., p. 192; and Transcript in No. 2306, p. 80)..... 81

The decided cases show that the defense of laches need not be pleaded 83

Defendant's horns do not infringe any of the three claims of the Nielsen patent in suit, if any of those claims are valid when properly construed. The decided cases hold that when a claim is explicit the courts cannot alter or enlarge it, even though the patentee may not have claimed the whole of his invention. Hence the claims of the Nielsen patent in suit must be limited by the outwardly-directed flanges, in which case defendant does not infringe, assuming, for the sake of argument, that any of the claims are valid 83

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Morse Chain Co. v. Link-Belt Co., 189 Fed., 584, 588. 84

It is well settled that the distinction between two claims of a patent must be maintained. Hence, Claim 2 must be differentiated from Claim 3. This can be done only by limiting Claim 2 to "strips of metal provided at their edges with longitudinal outwardly-directed flanges whereby the body portion of the horn is provided on the outside thereof with longitudinally-arranged ribs." Since defendant's horns employ the lock seam of the prior art and do not employ the outwardly-directed flanges, defendant does not infringe Claim 2. Claim 3 being clearly invalid, as shown above (supra, pp. 21-35, 36-63), defendant does not infringe, and the bill should be dismissed. 86

Where, as here, a patent is void for lack of invention in view of the prior art, extensive sales of the patented article are immaterial within the decisions of the courts 88

The horn of the Nielsen patent in suit, composed of strips secured together at their edges by outwardly-directed flanges, was an impractical construction. It never went into use. As shown, defendant's horns with the lock seam were constructed in accordance with the horns of the prior art. The advertisements of the National Phonograph Company in the Talking Machine World for December 15, 1907, and January, February and March 15, 1908, were presented by plaintiff, without notice, on the argument. Those advertisements merely set forth that the National Phonograph Company would thereafter supply well-constructed horns with its phonographs, as distinguished from poorly-constructed horns theretofore supplied by others for use with its phonographs. These advertisements are in no way binding on defendant..... 88

Where, as here, it appears that the Court below has exercised its discretion by granting a motion for preliminary injunction upon a wholly wrong comprehension of the facts and of the law of the case, the Circuit Court of Appeals will reverse. So also where, as here, new evidence is introduced, of such character that if it had been presented in the former case it would probably have led to a different conclusion, the Circuit Court of Appeals will reverse. Indeed, in such cases, the Circuit Court of Appeals will, at times, dismiss the bill for want of equity without compelling the parties to incur the expense of a final hearing 89

The decided cases show that the bill of complaint should be dismissed upon the hearing of this appeal, for the reason that it clearly appears: first, that the Nielsen patent in suit is invalid; and, second, that defendant does not infringe..... 90

Plaintiff does not show that defendant sold horns for phonographs in infringement of the Nielsen patent in suit..... 91

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Conclusion..... 93

United States Circuit Court of Appeals

FOR THE NINTH CIRCUIT.

PACIFIC PHONOGRAPH Co., a corporation,

Appellant,

vs.

SEARCHLIGHT HORN Co., a corporation,

Appellee.

No. 2314,

October term,

1913.

APPELLANT'S BRIEF.

Statement.

This is an appeal from an order granting an injunction in a suit in equity, enjoining defendant, *pendente lite*, from infringement of claims 2 and 3 of U. S. patent No. 771,441, issued October 4, 1904, to Nielsen, for "Horn for Phonographs or Similar Machines". The order was made by Judge Van Fleet and entered on June 24, 1913, in the District Court of the United States for the Northern District of California, Second Division (T., p. 209).

In an action at law, in the same Court, tried before Judge Van Fleet and a jury in October, 1912, the Searchlight Horn Co. obtained a judgment for damages and costs, for infringement of claim 2 or claim 3

of said Nielsen patent, against Sherman, Clay & Co., entered upon the verdict of the jury; and in June, 1913, said judgment was amended so that the damages awarded were reduced to the sum of one dollar (T., p. 37, and Transcript in No. 2306, pp. 18-20).

In a suit in equity brought by the Searchlight Horn Co. against Sherman, Clay & Co., an order granting a preliminary injunction was made by Judge Van Fleet in the same court in April, 1913 (Transcript in No. 2307, pp. 53-56). The injunction enjoined Sherman, Clay & Co., *pendente lite*, from infringement of claims 2 and 3 of said Nielsen patent and was granted by reason of the verdict of the jury in the action at law between the same parties.

No opinion was rendered by Judge Van Fleet in any one of the three cases. The injunction in the suit at bar was granted from the bench without any examination of the record or of defendant's brief other than that had upon the oral argument. The Court did not read the patents or affidavits nor did the Court look at defendant's brief.

An appeal by writ of error was taken to this court in the action at law against Sherman, Clay & Co., and is numbered, in this court, No. 2306. An appeal was also taken in the suit in equity against Sherman, Clay & Co., and is numbered, in this court, No. 2307. In its notice of motion, in the suit at bar, plaintiff set forth that it would rely upon the judgment roll in the action at law and upon the papers, pleadings and order for preliminary injunction in the suit in equity against Sherman, Clay & Co.; therefore, by stipulation in the suit at bar (T., p. 220), the transcripts of the Records therein are to be referred to upon the argument of this appeal. The notice of motion, in the equity suit against Sherman, Clay & Co. set forth that plaintiff would

rely upon the papers and pleadings together with the exhibits and testimony on file in the Record in the action at law. Hence, in the suit at bar, the entire Records in the action at law and in the suit in equity against Sherman, Clay & Co. are before this Court upon this appeal.

Assignment of Errors.

Appellant's assignment of errors, in support of its appeal from the order granting a preliminary injunction herein, upon each of which appellant relies, is as follows (T., p. 211):

I. The Court erred in granting said preliminary injunction.

II. The Court erred in not holding that claims 1, 2 and 3 of the Nielsen patent in suit, No. 771,441, and each of them, is void for lack of invention, in view of the prior art.

III. The Court erred in not holding that claims 1, 2 and 3 of the Nielsen patent in suit, No. 771,441, and each of them, is void, because anticipated by the patents, publications and uses of the prior art and by each of said patents, publications and uses of the prior art, adduced by said defendant.

IV. The Court erred in not holding that claims 1 and 2 of the Nielsen patent in suit and each of them is limited to longitudinal strips of metal, provided at their edges with longitudinal, outwardly directed flanges.

V. The Court erred in not holding that claim 3 is different from claims 1 and 2, and from each of said two claims of the Nielsen patent in suit No. 771,441.

VI. The Court erred in holding that defendant had infringed the Nielsen patent in suit No. 771,441, and in not holding that defendant had not infringed any of the claims of said patent.

VII. The Court erred in not holding that, in view of the prior art, the three claims of the said Nielsen patent, and each of them, is limited by strips provided at their edges with longitudinal outwardly directed flanges and that by reason of such limitation, said three claims and each of them were not infringed by defendant.

VIII. The Court erred in not denying the motion for preliminary injunction upon the ground that plaintiff had been guilty of laches and neglect for such a period of time before the bringing of this suit and the making of said motion, that it was not entitled to an injunction or to any relief in a Court of Equity.

IX. The Court erred in not holding that the horns of defendant, charged with infringement, were made and sold under the authority of the plaintiff, and that, therefore, defendant was not guilty of any infringement of said Nielsen patent.

X. The Court erred in not holding that there was no proof that the horns of defendant charged with infringement were not the horns put upon the market under the authority of the plaintiff, and that, therefore, there was no proof that defendant had infringed said Nielsen patent in suit.

XI. The Court erred in not dismissing the Bill of Complaint of plaintiff upon the ground that it appeared that the bill is lacking altogether in equity.

WHEREFORE, defendant prays that said order or decree, granting a preliminary injunction be reversed.

PLAINTIFF HAS MADE NO PROOF THAT IT HAS TITLE TO THE NIELSEN PATENT IN SUIT.

This Court has held that on motion for a preliminary injunction plaintiff must show a clear title to the patent (*Kings Co. v. U. S. Co.*, 182 Fed., 59, 61, C. C. A.).

It is elementary that the plaintiff was not entitled to an injunction *pendente lite* without proof of title (Walker on Patents, § 675, 3rd Ed.). In the action at law against Sherman, Clay & Co. defendant admitted that title to the Nielsen patent was vested in the plaintiff (Transcript in No. 2,306, p. 22). Of course, such an admission is not binding upon this defendant and affords no proof of title.

ENUMERATION OF THE EVIDENCE, RELIED UPON IN THE CASE AT BAR, THAT WAS NOT BEFORE THE PATENT OFFICE OR BEFORE THE COURT IN THE ACTION AT LAW OR IN THE SUIT IN EQUITY AGAINST SHERMAN CLAY & Co.

A. The patents cited by the Patent Office upon the application for the Nielsen patent in were only four.

They were as follows:

United States Patents.

No. 181,159 of Aug. 15, 1876 to Fallows (T., p. 241).

No. 612,639 of Oct. 18, 1898 to Clayton (T., p. 272).

No. 705,126 of July 22, 1902 to Osen *et al.* (T., p. 296).

British Patent.

No. 20,567 of 1902 to Tourtel (T., p. 356).

B. The following patents, publications and prior public uses, offered in evidence by defendant, were not before the Patent Office, nor before the Court in the prior action at law or suit in equity against Sherman, Clay & Co.

United States Patents.

- No. 31,772 of July 5, 1898 to Kaiser (T., p. 100).
 No. 362,107 of May 3, 1887 to Penfield (T., p. 243).
 No. 453,798 of June 9, 1891 to Gersdorff (T., p. 255).
 No. 491,421 of Feb. 7, 1893 to Gersdorff (T., p. 258).
 No. 534,543 of Feb. 19, 1895 to Berliner (T., p. 261).
 No. 632,015 of Aug. 29, 1899 to Hogan (T., p. 274).
 No. 647,147 of Apr. 10, 1900 to Myers (T., p. 277).
 No. 692,363 of Feb. 4, 1902 to Runge (T., p. 289).
 No. 738,342 of Sept. 8, 1903 to Marten (T., p. 299).
 No. 748,969 of Jan. 5, 1904 to Melville (T., p. 307).
 No. 763,808 of June 28, 1904 to Sturges (T., p. 310).
 No. 769,410 of Sept. 6, 1904 to Schoettel (T., p. 313).
 No. 770,024 of Sept. 13, 1904 to Ruggiero *et al.* (T., p. 316).
 No. 811,877 of Feb. 6, 1906 to Senne (T., p. 140).

British Patents.

- No. 22,612 of Apr. 15, 1899 to Hogan (T., p. 319).

- No. 9,729 of May 10, 1901 to Runge (T., p. 332).
 No. 22,273 of Nov. 5, 1901 to Runge (T., p. 338).
 No. 20,146 of Sept. 15, 1902 to Villy (T., p. 349).
 No. 5,186 of Mar. 5, 1903 to Cockman (T., p. 362).
 No. 14,730 of July 2, 1903 to Tourtel (T., p. 365).

French Patents.

- No. 301,583 of June 23, 1900 to Guerrero (T., p. 369).
 No. 318,472 of Feb. 17, 1902 to Turpin (T., p. 375).
 No. 321,507 of May 28, 1902 to Runge (T., p. 393).
 No. 331,566 of Apr. 28, 1903 to Hollingsworth (T., p. 402).

In addition to the foregoing patents the following *publications* should be added:

Scott's phonautograph of 1857 and Tewksbury's book of 1897 (T., p. 187, 155-156; 162, 152-153).

See also the subject-matter of the affidavits filed on behalf of defendants herein, showing *prior public uses* by Hawthorne (T., p. 57), George (T., p. 75), Stewart (T., p. 78), Kaiser (T., p. 84), Miller (T., p. 107) and Mecker (T., p. 127).

See also the affidavit of Senne showing that plaintiff's predecessor in title asserted that the Nielsen patent in suit covered horns made of paper (T., pp. 130-149).

C. The following patents were before the Court in the prior action at law and suit in equity against Sher-

man, Clay & Co. in addition to the four that were cited in the Patent Office. They made a meagre showing of the prior art.

United States Patents.

- No. 8,824 of Dec. 7, 1875, to Shirley (T., p. 231) for a *glass-vase*.
- No. 10,235 of Sept. 11, 1877, to Cairns (T., p. 233) for *speaking-trumpets*.
- No. 34,907 of Aug. 6, 1901, to McVeety & Ford (T., p. 235) for a *ship's ventilator*.
- No. 72,422 of Dec. 17, 1867, to Saxton (T., p. 237) for a *bell*.
- No. 165,912 of July 27, 1875, to Barnard (T., p. 239) for a *lamp-chimney*.
- No. 406,332 of July 2, 1889, to Bayles (T., p. 246) for a *metal pipe*.
- No. 409,196 of Aug. 20, 1889, to Hart (T., p. 249) for a *metal pipe*.
- No. 427,658 of May 13, 1890, to Bayles (T., p. 252) for a *metal pipe-section*.
- No. 648,994 of May 8, 1900, to Porter (T., p. 282) for a *horn*.
- No. 651,368 of June 12, 1900, to Lanz (T., p. 286) for a *metal beam*.
- No. 699,928 of May 13, 1902, to McVeety & Ford (T., p. 294) for a *ship's ventilator*.
- No. 739,954 of Sept. 29, 1903, to Villy (T., p. 302).

British Patents.

- No. 7,594 of Apr. 24, 1900, to Hogan (T., p. 323) for a *horn*.
- No. 17,786 of Aug. 13, 1902, to Fairbrother (T., p. 342) for a *horn*.

THE DESCRIPTION OF THE NIELSEN PATENT IN SUIT,
 NO. 771,441 OF OCTOBER 4, 1904, FOR HORN FOR
 PHONOGRAPHS AND SIMILAR MACHINES (T.,
 p. 28).

In a *stock phrase* of his patent solicitors, Nielsen set forth that the object of his invention was to "do away with the mechanical, vibratory and metallic sound usually produced in the operation of such machines and also produce a full, even and continuous volume of sound in which the articulation is clear, full and distinct" (T., p. 29, lines 14-19). The same patent solicitors used precisely these same words when, in U. S. patent No. 770,024 of September 13, 1904, to Ruggiero *et al.*, for horn for phonographs or similar machines, they described the invention in that patent, which consisted of "a horn for phonographs and similar machines, composed of separate layers of fibrous material, each of said layers being composed of separate longitudinal strips arranged so as to break joints" (T., p. 317, lines 15-20; p. 318, claims 1 and 2).

In the description of the Nielsen patent in suit, the following description of a horn, comprising the features claimed in the claims as constituting Nielsen's invention is given (T., p. 29, lines 31-77):

"In the practice of my invention, I provide a horn a , provided at its smaller end with the usual nozzle-piece a^2 , by means of which connection is made with the machine, and in the form of construction shown a supplemental piece a^3 is employed between the larger or body portion of the horn and the nozzle-piece a^2 ; but the parts a^3 and a^2 may be formed integrally, if desired, and may be constructed in any desired manner. The main part a of the horn is bell-shaped in form and tapers outwardly gradually from the part a^3 to the larger or mouth end a^4 , and this curve or taper is greater or

more abrupt adjacent to said larger or mouth end. The body portion of the horn is also composed of a *plurality* of longitudinal strips b , which are gradually *tapered* from one end to the other, and which are connected longitudinally, so as to form longitudinal ribs b^2 , *each of the strips b being provided at its opposite edges with a flange b^3 , and these flanges of the separate strips b are connected to form the ribs b^2 .* The body portion of the horn or the strips b are composed of sheet metal, and it will be observed that the inner wall of the body portion of said horn in cross-section is made up of a plurality of short lines forming substantially a circle, and it is the construction of the body portion of the horn as hereinbefore described that gives thereto the qualities which it is the objects of this invention to produce, which objects are the result of the formation of the horn or the body portion thereof of longitudinal strips b and providing the outer surface thereof with the longitudinal ribs b^2 and curving the body portion of the horn in the manner described. If desired, the part a^3 may be formed integrally with the body portion of the horn, in which event the ribs b^2 would extend to the nozzle or connecting portion a^2 , and *it is the longitudinal ribs b^2 which contribute mostly to the successful operation of the horn*, said ribs serving to do away with the vibratory character of horns of this class as usually made and doing away with the metallic sound produced by the operation thereof."

The foregoing constitutes the entire description of the horn. It will be observed that there is no specification of the number of longitudinal strips b , except that there shall be "a plurality". According to Webster's and other standard dictionaries the word "*plurality*" means "*two or more*". It is the noun derived from the adjective "plural", which means "*more than one*".

Plaintiff's expert, Mr. Vale, testified, in the action at law against Sherman, Clay & Co. (T., pp. 191-192; and Transcript in No. 2306, p. 121):

"Q. What distinction, if any, do you make between the term 'plurality' and the term 'multiplicity'?"

A. I should say a multiplicity would mean more than a plurality.

Q. *Two would be a plurality, would it not?*

A. *Yes.*"

It should also be observed that there is no description of the *strips b*, except the statement that they "are gradually *tapered* from one end to the other". According to Webster's and other standard dictionaries, the definition of the adjective "taper" is as follows:

"regularly narrowed toward the point; becoming small toward one end; conical; pyramidal; as, taper fingers."

The verb "taper" has the same meaning.

The definition of the longitudinal ribs b^2 is important. The patent says that the strips b :

"are connected longitudinally, so as to form longitudinal ribs b^2 , *each of the strips b being provided at its opposite edges with a flange b^3 , and these flanges of the separate strips b are connected to form the ribs b^2 .*"

Claims 1 and 2 set forth that the strips b are

"provided at their edges with *longitudinal outwardly-directed flanges* whereby said strips are connected and *whereby the body portion of the horn is provided on the outside thereof with longitudinally-arranged ribs.*"

The description emphasizes the importance attributed by Nielsen to the longitudinal ribs so con-

structed, by joining together *two outwardly-directed flanges*. The description says:

“it is the longitudinal ribs b^2 which contribute mostly to the successful operation of the horn, said ribs serving to do away with the vibratory character of horns of this class as usually made and doing away with the metallic sound produced in the operation thereof”.

The file wrapper and contents of the Nielsen patent in suit shows that Nielsen regarded the longitudinally-arranged ribs b^2 , constructed by joining together two outwardly-directed flanges, as the distinguishing feature of his invention. Throughout the prosecution of his application he pointed out no other feature. He said (T., pp. 172-173):

“The references cited in this case do not show a horn for talking machines having longitudinally-arranged ribs on the outer side thereof * * * *It is the longitudinally-arranged ribs on the outer side of the horn which produce the result claimed by applicant, and favorable action is respectfully requested*”.

CLAIMS OF THE NIELSEN PATENT IN SUIT, No. 771,441 OF OCTOBER 4, 1904 (T., p. 29).

The patent has three claims, which are as follows:

“1. A horn for phonographs and similar machines, the body portion of which is composed of longitudinally-arranged strips of metal *provided at their edges with longitudinal outwardly-directed flanges* whereby said strips are connected and *whereby, the body portion of the horn is provided on the outside thereof with longitudinally-arranged ribs*, substantially as shown and described.

“2. A horn for phonographs and similar machines, the body portion of which is com-

posed of longitudinally-arranged strips of metal *provided at their edges with longitudinal outwardly-directed flanges* whereby said strips are connected and *whereby, the body portion of the horn is provided on the outside thereof with longitudinally-arranged ribs*, said strips being *tapered* from one end of said horn to the other, substantially as shown and described.

“3. A horn for phonographs and similar instruments, said horn being larger at one end than at the other and *tapered in the usual manner*, said horn being composed of longitudinally-arranged strips secured together at their edges and the outer side thereof at the points where said strips are secured together being *provided with longitudinal ribs*, substantially as shown and described”.

The notice of motion for preliminary injunction prayed an injunction restraining defendant, *pendente lite*, from infringing claims 2 and 3 of the Nielsen patent (T., p. 11). The motion was granted as prayed for (T., p. 209).

It is to be observed that claims 1 and 2 are limited by “longitudinal *outwardly-directed flanges* whereby * * * the body portion of the horn is provided on the outside thereof with longitudinally-arranged ribs”.

Claim 2 is the same as claim 1, except that at the end of claim 2, the following words appear:

“said strips being *tapered* from one end of said horn to the other”.

The meaning of the word “taper” has been given above (*supra*, pp. 10-11).

The claims are to be construed according to the plain meaning of their words (See cases cited, *infra*, pp. 29-35).

With regard to claim 3 it is to be observed that the horn is “*tapered in the usual manner*”. In claim 3

this limitation is applied to the *horn*, while in claim 2 the limitation is that the *strips* are “*tapered* from one end of said horn to the other”. The language of claims 2 and 3 was intended to cover and clearly does cover strips or horns which taper in the usual manner, according to the ordinary and popular meaning of the term “taper”.

Claim 3 differs from claim 2 in that in claim 3 there is no limitation of the *material* from which the strips are to be made. In claims 1 and 2 the strips are limited to “strips of metal”. Claim 3 differs from claims 1 and 2 also in that in claim 3 the construction of the longitudinal ribs is not defined, claim 3, stating merely that the outer side of the horn “at the points where said strips are secured together being *provided with longitudinal ribs*”.

According to the well-settled rules of the patent law, the distinction between claim 3 and claim 2 must be maintained. The claims cannot be distinguished from each other by reason of the fact that in claim 2 the strips are said to be of metal, since the use of metal instead of any other suitable material would be a mere substitution of material; and the substitution of one material for another does not involve invention (See authorities cited, *infra*, pp. 72-73).

Hence, the difference between claims 1 and 2, on the one hand, and claim 3, on the other hand, resides in the limitation of claims 1 and 2 to the effect that the strips of metal are “provided at their edges with longitudinal *outwardly-directed flanges* whereby * * * the body portion of the horn is provided on the outside thereof with longitudinally-arranged ribs”, and in the limitation of claim 3 to the effect that the outer side of the horn “at the points where said strips are secured together” is “*provided with longitudinal ribs*”.

THE FILE WRAPPER AND CONTENTS OF THE APPLICATION FOR THE NIELSEN PATENT IN SUIT SHOWS THAT BOTH THE PATENT OFFICE AND NIELSEN UNDERSTOOD THAT THE EXPRESSIONS "A HORN TAPERED IN THE USUAL MANNER" AND "TAPERED STRIPS" MEANT THAT THE HORN AND THE STRIPS "TAPERED" IN THE ORDINARY AND COMMON MEANING OF THE WORD. THE CLAIMS REJECTED BY THE EXAMINER AND CANCELED BY NIELSEN SHOW THAT CLAIMS 1 AND 2 WERE ALLOWED BECAUSE OF THE LIMITATION THAT THE HORN WAS COMPOSED OF STRIPS "PROVIDED AT THEIR EDGES WITH LONGITUDINAL OUTWARDLY-DIRECTED FLANGES WHEREBY * * * THE BODY PORTION OF THE HORN IS PROVIDED ON THE OUTSIDE THEREOF WITH LONGITUDINALLY-ARRANGED RIBS", AND THAT CLAIM 3 WAS ALLOWED BECAUSE THE HORN WAS COMPOSED OF "STRIPS SECURED TOGETHER AT THEIR EDGES AND THE OUTER SIDE THEREOF AT THE POINTS WHERE SAID STRIPS ARE SECURED TOGETHER BEING PROVIDED WITH LONGITUDINAL RIBS".

Nielsen presented three claims which were rejected by the examiner and canceled. The rejected and canceled claims were as follows:

"3. A horn for phonographs and similar machines, *said horn being tapered in the usual manner* and the body thereof on the outer side thereof being provided with longitudinally-arranged *ribs*, substantially as shown and described (T., p. 170).

"4. A horn for phonographs and similar machines, *said horn being tapered in the usual manner* and the body thereof on the outer side thereof being provided with longitudinally-arranged *ribs* between which *the longitudinal parts of the horn taper* from one end to the

other, substantially as shown and described (T., p. 172).

“5. A horn for phonographic and similar instruments, said horn being larger at one end than at the other, and being composed of longitudinal *tapered strips*, which are secured together at their edges, substantially as shown and described”.

Canceled claim 3 was rejected (T., p. 172) upon British patent No. 20,567 of 1902 to Tourtel (T., p. 356), and upon U. S. patent No. 181,159 of August 15, 1876 to Fallows (T., p. 241).

Canceled claims 3 and 4 were rejected (T. p., 174) upon U. S. patent No. 612,639 of October 18, 1898, to Clayton (T., p. 272).

Canceled claims 3, 4 and 5 were rejected (T., pp. 178-180) upon the patents above cited and upon U. S. patent No. 705,126 of July 22, 1902, to Osten *et al.* (T., p. 296).

No references, other than the four above named, were cited by the Patent Office. All of the references, cited by the Patent Office in rejection of canceled claims 3, 4 and 5, showed *conical* or *pyramidal* horns that “*tapered in the usual manner*”; that is to say, the sides of the horns formed *straight* lines longitudinally of the horn and *did not curve*. The patent to Osten *et al.*, No. 705,126 (T., p. 296), showed a *pyramidal horn of four sides*, composed of four tapering strips of any suitable material, *such as wood*. The horn of the patent to Osten *et al.*, is described as follows (T., p. 297, lines 45-57):

“A is the body of the horn, which, as shown, is made of four *tapering thin wooden sides a a a¹ a¹*, secured together along their edges, thus forming a body part of rectangular cross-sec-

tion. The body part may, however, be made of circular, oval or any other suitable shape in cross-section”.

The foregoing points are of great importance, as will hereinafter be more fully shown, for the reason that the District Court has erroneously held, and was obliged to hold, in order to sustain the patent and find infringement, (1) that the word “*tapered*” meant something other than its accepted meaning and something other than it was understood to mean by the Patent Office and by Nielsen upon the application for the patent; and (2) that claim 3, of the patent as issued, was limited to a *metal* horn although no such limitation appears in the claim.

Referring to canceled claim 3, it appears that a *horn* that “*tapered in the usual manner,*” and was provided on the outside thereof with “longitudinally-arranged ribs” was not patentable, being devoid of invention and anticipated.

Referring to canceled claim 4, it appears that a *horn* that “*tapered in the usual manner*” and was provided with “longitudinally-arranged ribs,” between which the longitudinal “*parts*” of the horn “*tapered*” from one end to the other, was not patentable, being devoid of invention and anticipated.

Referring to canceled claim 5, it appears that a horn, larger at one end than at the other and composed of longitudinal “*tapered strips*” secured together at their edges, was not patentable, being devoid of invention and anticipated.

It is respectfully submitted that the foregoing proceedings in the Patent Office conclusively, show in what sense the word “*tapered*” is used in the description and claims of the patent in suit, as issued. It was used in its ordinary and popular sense and was *in no way re-*

stricted to a curve either of the horn itself or of the strips of which the horn was composed. It included, and was intended to include, a *conical* or a *pyramidal* horn, the lines of which are *straight* longitudinally of the horn; and it included, and was intended to include, tapering strips the sides or edges of which formed *straight* lines. The Patent Office so asserted. Nielsen acquiesced in the assertion. There was a meeting of minds and an agreement between the Patent Office and Nielsen upon this proposition. And thereupon the patent, with these expressions, "said strips being tapered from one end of said horn to the other" (claim 2) and "said horn, being larger at one end than at the other and tapered in the usual manner" (claim 3), was issued. Nielsen and his assignees are now estopped to deny that such expressions have any other meaning than their usual and ordinary meaning, which was the meaning agreed upon in the Patent Office.

That Nielsen intended that the expressions, "said strips being *tapered* from one end of said horn to the other" (claim 2) and "said horn, being larger at one end than at the other and *tapered in the usual manner*", should be taken in their usual and ordinary meaning, as indeed they must be, is apparent from the statement of the specification that (T., p. 29, lines 80-83):

"changes in and modifications of the construction described may be made without departing from the spirit of my invention or sacrificing its advantages".

Clearly, therefore, Nielsen intended by claims 2 and 3 to cover "strips" and "horns" that "tapered" in the *usual* manner and did *not* intend to limit those claims to any specific or unusual taper. He intended to include, and did include, all strips and all horns

having any usual or common kind of taper, for he believed that the novelty of his supposed invention resided in his longitudinal ribs b^2 formed by the outwardly-directed flanges, in a horn having a plurality (more than one) of tapering strips.

This *principle* was, in effect, conceded by plaintiff's counsel, when, referring to claim 3, he said (Transcript in No. 2306, p. 64) :

“it (claim 3) leaves the joinder of the two pieces of metal to be of *any kind* so long as it is of such a kind as to produce the longitudinal ribs on the outside”.

It is also respectfully submitted that the rejection of canceled claims 3, 4 and 5, upon the patent to Osten *et al.* (T., pp. 178-180), conclusively shows that claim 3 of the patent, as issued, *cannot be limited to a metal horn*, as held by the District Court. It included, and was intended to include, a horn made of *any* suitable material, such as the wooden horn of the patent to Osten *et al.* It also conclusively shows that no invention was involved in making Nielsen's horn of metal, rather than of any other suitable material known in the art as the equivalent of metal, such as wood, celluloid, cardboard, paper and other like flexible material (*infra*, pp. 71-72; and cases cited, pp. 72-73).

Canceled claims 3, 4 and 5 were rejected (T., pp. 172, 178-180), as stated above, upon British patent No. 20,567 of 1902 to Tourtel (T., p. 356). The patent to Tourtel is as instructive as the patent to Osten *et al.*, with respect to the meaning of the claims of the Nielsen patent in suit. Tourtel showed a *conical* horn made of “*celluloid or any other sufficiently light and resonant material.*” The conical body D of the horn was provided with a rim or bell 7 at its large end. Tourtel

made his conical horn of a *single* sheet of celluloid or other suitable material, the edges of which were joined together in a V-shaped lap-seam to form a rib (Fig. 4) extending longitudinally of the horn for the entire length of the horn, from the lower edge of the rim or bell 7 to the junction of the small end of the horn with the recording or reproducing stylus 10.

This construction Tourtel described briefly as follows (T., p. 358, lines 40-48):—

“The novelty of the construction of the trumpet resides in the arrangement for strengthening the same by the reinforcement of its lower part in the manner especially illustrated in Figure 4. *The material of the trumpet which may be conveniently celluloid, or any other sufficiently light and resonant material, is curved to join at the edges into the form required, said join being in the shape of a V-shaped ridge running the entire length of the trumpet from the lower edge of the rim to the junction with the stylus. By this construction, the need of any special strengthening bars or reinforcement of other materials is obviated.*”

The Patent Office held that Tourtel's horn was an anticipation of all the claims presented by Nielsen, except the three claims of the patent in suit, which differ from the canceled claims only in that they show a *plurality* (more than one) of strips, joined together at their edges to form a *plurality* (more than one) of longitudinal ribs on the outside of the horn, and in that claims 1 and 2 of the patent are limited to *such a horn*, having the ribs formed by longitudinal *outwardly-directed flanges*. Tourtel showed *only one* strip or sheet of celluloid or other suitable material, the edges of which, when joined together, formed *only one* longitudinal rib on the outside of the horn. Had Tourtel used

two strips or sheets of celluloid and thus formed *two* longitudinal ribs, he would have anticipated claim 3 of the Nielsen patent, as issued, and he would have anticipated claims 1 and 2 of the Nielsen patent, as issued, unless claims 1 and 2 are limited to ribs formed by the outwardly-directed flanges.

We thus see how extremely narrow Nielsen's invention was considered to be, and was conceded by Nielsen to be, when, in the Patent Office, only a very few of the references of the prior art were cited.

THE PROCEEDINGS IN THE PATENT OFFICE SHOW THAT CLAIM 3 OF THE NIELSEN PATENT IN SUIT IS ANTICIPATED BY THE TWO-STRIP METAL HORN USED BY MILLER AND MEECKER IN 1897, BY THE TWO-STRIP METAL HORN USED BY EMERSON IN 1898; AND BY SEVERAL PATENTS, IN EVIDENCE, OF THE PRIOR ART, SHOWING HORNS, TAPERING IN THE USUAL MANNER, COMPOSED OF TWO OR MORE TAPERING STRIPS OF SUITABLE MATERIAL JOINED TOGETHER AT THEIR EDGES IN A MANNER TO FORM TWO OR MORE LONGITUDINAL RIBS ON THE OUTSIDE OF THE HORN, EXTENDING FROM ONE END TO THE OTHER OF THE HORN; AND THAT CLAIMS 1 AND 2 ARE ALSO ANTICIPATED THEREBY UNLESS CLAIMS 1 AND 2 ARE LIMITED TO RIBS FORMED BY OUTWARDLY-DIRECTED FLANGES.

Photographs of the two-strip metal horn used by Miller and Meecker in 1897 are set forth at pages 124-125 of the transcript. The horn and its use are explained in Miller's affidavit (T., pp. 107-110) and in Meecker's affidavit (T., pp. 127-129).

A photograph of the two-strip metal horn used by Emerson in 1898 and a description of the horn and its use are set forth in Emerson's affidavit (T., pp. 193-196).

The horns used by Miller and Meecker and by Emerson, in the prior art, consisted of *two* tapering strips of metal, joined together at their edges by the tinsmith's or lock-seams, which formed *two* longitudinal ribs upon the outside of the horn, extending from one end to the other of the horn. The horns were conical, thus "tapering in the usual manner" of horns, as explained above (*supra*, pp. 15-21). The horn used by Miller and Meecker was provided with a bell. As shown above (*supra*, p. 21), had these horns been before the Patent Office claim 3 would have been rejected; and so would claims 1 and 2, had not claims 1 and 2 been limited by the *outwardly-directed flanges*, which defendant does not use.

The following patents of the prior art show horns for phonographs, "*tapering in the usual manner*" of horns, composed of *two or more tapering strips* of suitable flexible material, joined together at their edges in a manner to form *two or more longitudinal ribs* on the outside of the horn, extending from one end to the other of the horn.

1. U. S. Patent, No. 648,994, of May 8, 1900, to Porter (T., p. 282, Fig. 1).

Porter says (T., p. 284, lines 18-22):

"I form the horn from moderately-thin pressboard, celluloid, or *other material capable of ready, but not too easy bending*, and divide it longitudinally into *two or more sections* * * *."

As shown in Fig. 1 (T., p. 282) the edges of the tapering sections are joined together by lap-seams, which form *two or more ribs* extending longitudinally on the outside and inside of the horn, as in defendant's horns.

2. *U. S. Patent, No. 748,969, of Jan. 5, 1904, to Melville (T., p. 307, Fig. 1).*

Melville shows a horn, "composed of two tapering sections of cardboard, linoleum, leather, or any similar material" (T., p. 308, lines 53-54), united at their edges by two longitudinal ribs *c* on the outside of the horn, but he says (T., p. 308, lines 91-93) :

"I do not desire to confine myself to the employment of any particular number of sections."

3. *U. S. Patent, No. 763,808, of June 28, 1904, to Sturges (T., p. 310, Figs. 1 and 2).*

Sturges shows a horn composed of *sixteen* tapering sections, of any suitable material, the edges of which are beveled so as to form longitudinal ridges on the outside of the horn (Fig. 2) and form a strong and durable body (T., P. 311, lines 53-58).

4. *British Patent No. 22,273, of Nov. 5, 1901, to Runge (T., p. 341, Fig. 2).*

Runge made his horn "of flexible sheet material such as celluloid, its edges being joined by a metal clip B which forms a longitudinal stiffener along one side of it" (T., p. 339, lines 35-37); but Runge says that *a series of metal strips B* may be employed, the fold or crease *C* of Fig. 2 being eliminated (T., p. 339, lines 13-21).

5. *French Patent No. 318,742, of Feb. 17, 1902, to Turpin (T., p. 380, Figs. 8-16).*

As hereinafter shown this patent is a complete anticipation of the Nielsen patent in suit (*infra*, pp. 36-42).

6. *French Patent No. 321,507, of May 28, 1902, to Runge (T., p. 395, Fig. 2).*

This patent is like Runge's British patent No. 22,273 of 1901, considered *supra*, except that the French patent states that the longitudinal ribs *B* improve the sound-producing qualities of the horn, as does the Nielsen patent in suit and as does British patent, No. 22,612 of April 15, 1899, to Hogan (T., p. 320, lines 20-22). In Runge's French patent, claim 1 reads (T., p. 400);—

“1st. In a graphophone or talking machine, a horn having *two or more* longitudinal reinforcements (the ribs *B*) *serving to improve its sound-producing qualities.*”

Claims 1, 2 and 3 of the Nielsen patent read upon these horns of the prior art and are anticipated thereby unless claims 1 and 2 are limited as aforesaid, in which case defendant does not infringe.

7. *The decided cases show that no invention is involved in making two parts of one thing or one of two, when by such change no different result is attained. Hence, had Nielsen, contrary to the fact, been the first to construct a horn from two or more tapering strips, instead of one, such change would not have involved patentable invention.*

This proposition is established by the following cases:

D'Arcy v. Staples Co., 161 Fed., 733, 742; *Nathan v. Howard*, 143 Fed., 889, 893; *Mueller Mfg. Co. v. McDonaly Co.*, 164 Fed., 991, 996; *Keepers v. American Co.*, 177 Fed., 442; *Howard v. Detroit Stove Works*, 150 U. S., 164, 170; *Sheffield Car Co. v. D'Arcy*, 194 Fed., 686.

8. *Scott's Phonautograph of 1857* (T., pp. 187, 155-157).

In 1857 Leon Scott invented the phonautograph for recording sound waves. An illustration (T., p. 187) of Scott's phonautograph shows a horn constructed according to the description and claims of the Nielsen patent in suit. Scott's horn consisted of longitudinally-arranged *curved tapering strips, having curved meeting edges*. The horn was larger at one end than at the other end, thus *tapering in the usual manner of horns*. The longitudinally-arranged strips were secured together at their curved meeting-edges so as to form longitudinal *ridges or ribs* upon the outside of the horn. The longitudinally-arranged tapering strips and the ridges or ribs extended from one end to the other of the horn.

It very clearly appears from the illustration of Scott's phonautograph that the adjacent edges of the longitudinally-arranged tapering strips formed projecting ridges, ribs or sharp angles on the outside of the horn. These projections or sharp angles are like the *outwardly-directed* flanges of the Nielsen horn of the patent in suit.

The patents of the prior art show that the longitudinal ribs of the horn of Scott's phonautograph were precisely the same in effect and were the well-known equivalents of any of the many different kinds of longitudinal ribs employed in the horns of the prior art. For example, British patent No. 20,146 of 1902 to Villy specifically states (T., p. 351, lines 17-18):

"The angles formed by the meeting of the hinged segments (See the tapering strips in Figs. 1, 2 and 5) when extended form, as it were, *ribs giving rigidity to the trumpet form*".

The same thing is shown in U. S. patent No. 763,808, of June 24, 1904, to Sturges (T., p. 310, Fig. 2 and p. 311, lines 53-58); in British patent No. 22,273 of 1901 to Runge (T., p. 339, lines 13-21 and p. 341, C the equivalent of B in Fig. 2); in French patent No. 321,507, of May 28, 1902, to Runge (T., p. 399, par. 1 and p. 395, G^s the equivalent of G¹ in Fig. 2); and in other patents of the prior art referred to in defendant's affidavits (T., pp. 116-117, 120).

It thus appears that the first instrument devised for recording sound, "the precursor of the phonograph", employed a horn that anticipates the claims of the Nielsen patent in suit.

9. The evidence shows that a rib is a mere thickening of the material longitudinally of the horn; and that there may be a rib without a seam.

Plaintiff's expert, Mr. Vale, testified in the action at law against Sherman, Clay & Co. (T., p. 191; and Transcript in No. 2036, p. 110):

"Q. What is your impression of a seam, your definition, your mechanical definition of a seam?

A. It would be that portion of any two edges joined together.

Q. How does a rib differ mechanically from a seam?

A. Well, *a rib is a thickening in cross sections within narrow longitudinal limits of the body of any material. It might be an overlapping of that material, or it might be an integral thickening of it and still be a rib.*

The Court. Q. *There might be a rib without a seam?* A. *Yes.*

Q. And a seam might be so constructed as to constitute a rib? A. *Yes.*

Mr. Acker. Q. Is it your understanding that

any seam that has any thickening of the metal constitutes a rib?

A. To a certain extent, yes, if there is any over-lapping of the body of the two joined parts."

IN 1905, THE OWNERS OF THE NIELSEN PATENT IN SUIT CLAIMED, IN A PROPOSED WRITTEN CONTRACT SUBMITTED TO SENNE, THAT THE CLAIMS OF THE PATENT COVERED HORNS MADE OF PAPER STRIPS AS WELL AS HORNS MADE OF METAL STRIPS (T., PP. 130-149, 150-152, 158-161). HENCE, THE HORNS OF THE PRIOR ART MADE OF STRIPS OF WOOD, PAPER, CELLULOID AND THE LIKE ANTICIPATE, UNDER THE WELL-SETTLED RULE THAT "THAT WHICH INFRINGES, IF LATER, ANTICIPATES, IF EARLIER."

Mr. Senne shows by his affidavit that the construction put upon the claims of the Nielsen patent by the owners thereof proves that the patent is anticipated by the patents and publications of the prior art, describing horns for phonographs, composed of tapering strips of any suitable, flexible sheet-material, joined together at their edges in a manner to form longitudinal ribs on the outside of the horn.

The Court is respectfully referred to Mr. Senne's affidavit and to the photographs thereto annexed of the paper horns produced by him (T., pp. 130-149, 150-152, 158-161).

The construction put by the owners of the Nielsen patent upon the claims of that patent is shown by Mr. Senne from a suit brought against him upon the patent and from a *contract* (T., pp. 145-149), submitted to him by the owners of the patent for a payment of royalty under the patent. Mr. Senne annexes to his affidavit a copy of the contract proposed to him by the owners of the patent, taking the position that horns

made of tapering strips of *paper*, joined together at their edges and provided with longitudinal ribs on the outside of the horn were infringements of the Nielsen patent and that Senne could not make the same without payment of royalty under the patent. Clearly, then, under their own construction of the Nielsen patent, the claims thereof are anticipated and void by reason of such patents in the prior art as French patent No. 318,742 of February 17, 1902, to Turpin (T., pp. 380-381, Figs. 8-16), British patent No. 20,146 of September 15, 1902 (T., p. 354, Fig. 5; p. 355, Fig. 8), by reason of the Kaiser horn of the prior art (T., pp. 102, 100), and by reason of other like patents, publications and structures innumerable in the prior art.

The affidavit of Mr. Hicks (T., pp. 150-152, 158-161) bears out the affidavit of Mr. Senne with reference to the proceedings had in the suit brought against Senne *et al.* upon the Nielsen patent and with reference to the contract proposed by the owners of the patent to Senne.

It is well settled that a proper test of the validity of a patent is in the application of the rule that "what would infringe, if later, anticipates, if earlier" (*Knapp v. Morss*, 150 U. S., 221, 228).

Complainant stands in the shoes of the former owner of the Nielsen patent (*Woodmanse Co. v. Williams*, 68 Fed., 489, 492).

Hence, it is clear not only that the claims of the Nielsen patent are anticipated by the patents of the prior art showing horns for phonographs, constructed of tapering strips of sheet-material, such as wood, paper, celluloid and the like, secured together at their edges by seams forming longitudinal ribs, but that the owners of the Nielsen patent have themselves asserted that such horns would infringe the claims of the Niel-

sen patent, with the result that the claims of the Nielsen patent are clearly invalid since it now appears that such horns were described and used in the prior art.

TO IMPLY AS ELEMENTS OF A CLAIM LIMITATIONS NOT SET FORTH THEREIN FOR THE PURPOSE OF LIMITING ITS SCOPE, SO THAT IT MAY BE ACCORDED NOVELTY IS CONTRARY TO A WELL-SETTLED RULE OF THE PATENT LAW. THE DISTRICT COURT IN CHARGING THE JURY, IN THE SHERMAN, CLAY & CO., ACTION AT LAW, COMMITTED THIS ERROR, ERRONEOUSLY CHARGING THE JURY THAT THE HORN OF "THE CLAIMS" OF THE NIELSEN PATENT HAD "SUBSTANTIALLY A BELL-SHAPE" AND THAT "THE STRIPS MUST CURVE OUTWARDLY FROM THE INNER TO THE OUTER END, BUT THE CURVE IS MORE ABRUPT ADJACENT TO THE OUTER END".

In *Coupe v. Royer*, 155 U. S., 565, 575-577, the Supreme Court reversed for just such an error. The claim was limited by a "*vertical shaft*" but the trial Judge, disregarding the words of the claim, charged the jury that the claim was infringed by a "*horizontal shaft*".

The meaning of the word "tapered" in claims 2 and 3 of the Nielsen patent in suit has been shown above (*supra*, pp. 10-11, 13-14, 15-21).

There is nothing whatever in the claims of the Nielsen patent to warrant the charge of the District Court that the horn of the claims had "*substantially a bell-shape and abruptly flaring outlet*" or that "*the strips must curve outwardly from the inner to the outer end, but the curve is more abrupt adjacent to the outer end.*" The decided cases show that this holding of the District Court was a clear error of law. Had the District Court not read such limitations into the claims, the claims would clearly have been anticipated by the evidence introduced in the Sherman, Clay & Co. suit.

In *Stearns & Co. v. Russell*, 85 Fed., 218, 224, Judge Taft, speaking for the C. C. A., said:—

“To imply as elements of a claim parts not named therein for the purpose of limiting its scope, so that it may be accorded novelty, is contrary to a well-settled rule of the patent law. It was proposed to limit a claim thus in *McCarty v. Railroad Co.*, 160 U. S. 110, 116. The patent there under consideration was for a car truck bolster. Mr. Justice Brown, in delivering judgment for the Supreme Court, said (page 116):

‘There is no suggestion in either of these claims that the ends of the bolster rest upon springs in the side trusses, although they are described in the specification and exhibited in the drawings. It is suggested, however, that this feature may be read into the claims for the purpose of sustaining the patent. While this may be done with a view of showing the connection in which a device is used, and proving that it is an operative device, we know of no principle of law which would authorize us to read into a claim an element which is not present, for the purpose of making out a case of novelty or infringement. The difficulty is that if we once begin to include elements not mentioned in the claim in order to limit such claim, and avoid a defense of anticipation, we should never know where to stop. If, for example, a prior device were produced exhibiting the combination of these claims plus the springs, the patentee might insist upon reading some other element into the claims, such, for instance, as the side frames and all the other operative portions of the mechanism constituting the car truck, to prove that the prior device was not an anticipation. It might also require us to read into the fourth

claim the flanges and pillars described in the third. *This doctrine is too obviously untenable to require argument.'*"

In *Universal Co. v. Sonn et al.*, 154 Fed., 665, 668 (C. C. A.), Judge COXE said:

"We are asked to reconstruct the claims by substituting the word 'face' for the word 'contracted' and adding to the claim the following:

" 'Said face aperture being sufficiently narrow or contracted to retain said composition.'

"Whether such a claim, if originally inserted in a patent describing a metal brush back, would disclose invention and an operative method of construction we are not called upon to decide; *it is enough that the patentee did not so word the claim and it is beyond the province of the court to rewrite it.* In *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U. S., 274, Mr. Justice BRADLEY, at page 278 of 95 U. S., says:

" 'They (the patentees) cannot expect the courts to wade through the history of the art, and spell out what they might have claimed. * * * But the courts have no right to enlarge a patent beyond the scope of its claims as allowed by the Patent Office. * * * As patents are procured *ex parte*, the public is not bound by them, but the patentees are. *And the latter cannot show that their invention is broader than the terms of their claim, or, if broader, they must be held to have surrendered the surplus to the public.'*

"See, also, cases cited in *National Bunching Co. v. Williams*, 44 Fed., 190, 194."

In *Merrill v. Yeomans*, 94 U. S., 568, 573, Mr. Justice MILLER said:

"The growth of the patent system in the last quarter of a century in this country has reached

a stage in its progress where the variety and magnitude of the interests involved require accuracy, precision, and care in the preparation of all the papers on which the patent is founded. It is no longer a scarcely recognized principle, struggling for a foothold, but it is an organized system, with well-settled rules, supporting itself at once by its utility, and by the wealth which it creates and commands. The developed and improved condition of the patent law, and of the principles which govern the exclusive rights conferred by it, *leave no excuse for ambiguous language or vague descriptions. The public should not be deprived of rights supposed to belong to it, without being clearly told what it is that limits these rights.* The genius of the inventor, constantly making improvements in existing patents—a process which gives to the patent system its greatest value—should not be restrained by *vague and indefinite descriptions of claims* in existing patents from the salutary and necessary right of improving on that which has already been invented. It seems to us that nothing can be more just and fair, both to the patentee and to the public, than that the former should understand, and *correctly describe, just what he has invented, and for what he claims a patent*”.

In *White v. Dunbar*, 119 U. S., 47, 51, Mr. Justice Bradley said:

“Some persons seem to suppose that a claim in a patent is like *a nose of wax* which may be turned and twisted in any direction, by merely referring to the specification, so as to make it include something more than, or something different from, what its words express. The context may, undoubtedly, be resorted to, and often is resorted to, for the purpose of better understanding the meaning of the claim; but not for the purpose of changing it, and making it differ-

ent from what it is. The claim is a statutory requirement, prescribed for the very purpose of making the patentee define *precisely* what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from *the plain import of its terms*. This has been so often expressed in the opinions of this Court, that it is unnecessary to pursue the subject further. See *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U. S., 274, 278; *James v. Campbell*, 104 U. S., 356, 370."

Other cases showing the uniform application of the well-settled rule "that *the specification may not be read into a claim for the purpose of changing it, or to escape anticipation, or establish infringement*" are the following:

Muller Mfg. Co. v. Glauber, 184 Fed.,
609 614, (C. C. A.).

Simplex Co. v. Pressed Steel Co., 177
Fed., 426, 429 (C. C.).

Continental Co. v. Spaulding & Bros.,
177 Fed., 693, 708 (C. C.).

General Co. v. Netcher et al., 167 Fed.,
549, 558-559 (C. C.).

National Co. v. New England Co., 151
Fed., 19, 23 (C. C. A.).

Canda v. Michigan Co., 124 Fed., 486,
491 (C. C. A.).

Wilson v. McCormick Co., 92 Fed., 167,
172 (C. C. A.).

Boynton Co. v. Morris Co., 82 Fed., 440,
443 (C. C.).

*Keystone Bridge Co. v. Phoenix Iron
Co.*, 95 U. S., 274, 278.

Howe Machine Co. v. National Co., 134
U. S., 388, 394.

Cimiotti Co. v. American Co., 198 U. S.,
399, 410.

Paper Bag Patent Case, 210 U. S., 405,
419.

Reference to pages 272-273 of the transcript of the Record in the Sherman, Clay & Co. action at law, No. 2306, shows that, under the authorities cited above, Judge VAN FLEET erroneously charged the jury as follows:

“The invention of Nielsen consists in the production of a horn for phonographs and similar instruments consisting of a combination of the various elements hereinabove described by me, and the essential characteristics of the Nielsen horn are the following:

“1. It must be composed of a *multiplicity* of metal strips secured together at their longitudinal edges by a seam.

“2. This seam must be of such construction as to produce longitudinal ribs on the outer surface of the horn.

“3. The strips are narrower in cross-sections at the inner end than at the outer end.

“4. *The strips must curve outwardly from the inner to the outer end, but the curve is more abrupt adjacent the outer end.*

“Now, combining these elements together in this way, Nielsen produced a horn for phonographs and similar machines larger at one end than the other and *having substantially a bell-shape and abruptly flaring outlet* made up of longitudinally arranged *metal strips* secured together at their outer edges by a seam of such character as to produce longitudinal ribs on the outer surface.

“This is an explanation of the invention in

colloquial language rather than in technical form, and *I instruct you that it correctly represents the invention as protected by the claims in issue of the Nielsen patent.*"

The District Judge erred when he *read into the claims* of the Nielsen patent the limitation that "*the strips must curve outwardly from the inner to the outer end, but the curve is more abrupt adjacent the outer end*". He also erred when he *read into the claims* the limitation that the horn of the claims is one "*having substantially a bell-shape and abruptly flaring outlet*". He also erred when he *read into the claims* the limitation that the horn of the claims must be composed of a "*multiplicity*" of strips, as distinguished from a "*plurality*," since "*multiplicity*" means "*many*," whereas "*plurality*," the word used in the description, means merely "*more than one*". He also erred when he *read into claim 3* the limitation that the horn of claim 3 must be composed of "*metal*" strips, since claim 3 makes no limitation of the material of which the strips must consist. He also erred when he instructed the jury that this explanation "*correctly represents the invention as protected by the claims in issue of the Nielsen patent.*" It is very clear from a reading of the claims of the Nielsen patent that no such limitations are set forth. This matter has been fully pointed out above (*supra*, pp. 13-14, 15-21).

The District Judge further erred in instructing the jury that "*the claims in issue of the Nielsen patent*" (claims 2 and 3) had the same meaning; and erred in not instructing the jury that claim 2 was limited by *the outwardly-directed flanges* and that claim 3 was not limited to a horn made of *metal* strips (*Coupe v. Royer*, 155 U. S., 565, 575-577).

CLAIM 3 OF THE NIELSEN PATENT IN SUIT WAS ANTICIPATED, IN ANY VIEW OF THE CLAIM, BY THE PATENTS OF THE PRIOR ART. CLAIMS 1 AND 2 ARE ALSO ANTICIPATED UNLESS THOSE CLAIMS ARE LIMITED, AS THEY MUST BE, BY "STRIPS OF METAL PROVIDED AT THEIR EDGES WITH LONGITUDINAL OUTWARDLY-DIRECTED FLANGES WHEREBY * * * THE BODY PORTION OF THE HORN IS PROVIDED ON THE OUTSIDE THEREOF WITH LONGITUDINALLY-ARRANGED RIBS." THE PRINCIPAL REFERENCES RELIED UPON AS ANTICIPATIONS, IN THE SUIT AT BAR, WERE NOT BEFORE THE COURT EITHER IN THE ACTION AT LAW OR IN THE EQUITY SUIT AGAINST SHERMAN, CLAY & CO.

I. French patent No. 318,742, of February 17, 1902, to Turpin (T., p. 375; translation T., p. 383).

This patent was not before the District Court in the action at law or suit in equity against Sherman, Clay & Co.

The Turpin patent was applied for February 17, 1902, delivered, July 4, 1902, and published October 25, 1902 (T., pp. 375, 383).

In his specification Turpin sets forth that theretofore horns for phonographs, either for recording or for reproduction, had been made of pasteboard, celluloid, glass, crystal or metal, such as copper, tin, nickel, aluminum, German silver, etc. He points out certain disadvantages of pasteboard, celluloid or fibre and crystal, and states that horns of metal were the only ones employed.

He then states that, whatever one may do, horns of metal, including *hunting horns* which have the shape of the horns of Fig. 1 of the Nielsen patent in suit, give forth metallic, nasal sounds which render it impossible to reproduce or record, by a phonograph, the

violin, the notes of a singer or the music of orchestral pieces (T., pp. 383-386).

Therefore, Turpin proposes to construct horns for phonographs *of wood instead of metal*. The change involved *a mere substitution of material*, wood instead of metal. Turpin was correct in his use of wood instead of metal, because, as the evidence shows, the best horns for phonographs ever devised are horns of wood, made according to the methods shown in Turpin's patent. (Affidavits, T., pp. 91-94, 105, 111-112; 136-137; Patents, T., pp. 310, 349, 362, 375, etc.; plaintiff's exhibit, Catalogue of the Edison Phonographs, T., p. 12.)

Turpin describes, under the head of "PROCESS OF CONSTRUCTION", four ways in which to construct horns for phonographs from wood or from *wood combined with metal*. They are as follows:

1. Turning a horn from *a single block* of wood (T., p. 386).

2. Constructing a horn from *a single tapering strip of wood*, bent into the shape of a cone and secured together at its edges by over-lapping the edges to form a lap-seam and gluing the edges in that position, thereby forming a longitudinal rib extending from one end to the other of the cone (T., pp. 387-389; p. 379, Fig. 2).

3. Constructing a horn from *several tapering strips of wood* secured together at their edges and provided, as in the Nielsen patent in suit, at the points where said strips are secured together with longitudinal ribs, either on the outside or the inside of the horn, the ribs extending from one end to the other end of the horn (T., pp. 389-391; pp. 380-381, Figs. 8-16).

This horn may vary in form, from the circular form (cone) to that of a square, passing through all the pyramidal forms having a plurality of sides.

In Fig. 8, the horn is shown in the form of an octagonal pyramid, being composed of eight tapering strips of wood, provided with longitudinal ribs, which, as shown, in Figs. 9, 10, 11, 12 and 13, may be of wood or of metal, and upon the inside or the outside of the horn (T., pp. 380-381).

Or, as shown in Fig. 14 (T., p. 381), the horn (which is constructed in the same manner as the horn shown in Fig. 8, that is to say, of tapering strips of wood joined together at their edges and provided with longitudinal ribs of wood or metal, extending from one end to the other of the horn at the points where the strips are secured together), may be a horn having a curved or bell-shape, that is to say, the precise shape of the horn shown in Fig. 1 of the Nielsen patent in suit.

4. Constructing a horn, according to the preceding or third method, and employing *twelve tapering strips, some of which may be of metal, others of wood and others, if desired, of glass.*

Undoubtedly, the horns made according to the 3rd and 4th methods, described by Turpin, anticipate claim 3 of the Nielsen patent in suit and anticipate claims 1 and 2, unless, as stated above, claims 1 and 2 are limited by the "outwardly-directed flanges".

Turpin's description of making his horns, according to the 3rd and 4th methods is, in full, as follows (T., pp. 389-390):

"3rd. Horns of wood for veneering in several pieces.

“Figure 8 represents a horn of wood, of polygonal form (octagonal) which is constructed of strips B, nailed and glued, or one or the other, upon ribs of wood A (figs. 9 and 12, end views), serving as bracers or as a skeleton. The truncated pyramid thus obtained is then glued at C in a mouth-piece E of any metal. One then finishes the matter in the manner which has been set forth above.

“In place of ribs of wood, one can make use of metallic ribs (figs. 10, 11 and 13) to receive and maintain the sheets or strips of wood B. These ribs may be on the interior or on the exterior of the horn, which may vary in form, from the circular form (conc) to that of a square, passing through all the pyramidal forms having a plurality of sides.

“Figures 14, 15 and 16 show a truncated bell-shaped horn, with metallic bracing. A folded ring A forms the bracing of the bell in which the strips of wood B are engaged; the mouth-piece E carries a concentric envelope, detached but soldered at its base. In the space reserved between the double walls thus formed (fig. 16), the top of the cone of wood B is engaged and glued, the base being secured in the bell ring. To maintain the curvature, one may secure to the exterior a metallic or other ring O, connected to the mouth-piece E by rods T, soldered, glued or riveted at S and at O. The sheets of veneering, thus maintained, can effect the forms desired, by varying the form of the skeleton, and ribs and shape of the sheets of wood. The joints, if there is need of it, are secured by bands of veneering wood very thin and glued.

“4th. Horns of woods combined.

“In order to obtain a more complete concordance of the sounds by synchronism and isochronism, one may advantageously construct the horns of strips of wood of different kinds and also add thereto one or two strips of metal and

also of glass, so that when one records an orchestral piece, all the instruments find their harmonics and that the horn can vibrate in unison. *If, for example, the horn is a duodecagonal pyramid, that is with 12 strips, one may put in opposition:*

“2 strips of rosewood;

“2 *strips of metal* which may be composed of bands of different metals;

“2 strips of glass;

“2 strips of tulip;

“2 strips of red mahogany;

“2 strips of walnut.

“One obtains thus an ideal orchestral horn.

“For the voice and the song, the violin, the instruments of wood, it is necessary not only to employ wood, but to vary the kinds, which the polygonal form of my horns permits”.

In claim 4, Turpin claims his 3rd and 4th methods, which consist of constructing horns for phonographs from strips of wood, the horns *being of any shape and of any dimensions and being provided with longitudinal ribs on the outside or on the inside of the horn, extending from one end to the other end of the horn.*

Claim 4 reads as follows (T., p. 391);

“The methods of construction of said horns by the use of wood for veneering *cut into strips* and secured upon *ribs of wood or of any metal, internally or externally, whatever may be their forms and dimensions, as described above and finally specified*”.

In claim 5, Turpin claims the same method of construction of horns for phonographs from tapering strips of wood combined with tapering strips of metal. Claim 5 is as follows (T., p. 392);

“The methods of construction and of combination of combined horns, those horns of sev-

eral different woods, with or without vibrating glass *or metals*, as described above and finally specified”.

It is to be observed that the description above quoted of Figures 14, 15 and 16 is given under the heading of the third method, which is the method described for constructing horns *from several tapering strips of wood B*. The *details* of construction are shown in Figs. 8-13.

Fig. 14 is a sectional view, which shows the curved or bell-shape of the horn.

That the construction of the bell-shaped horn shown in Fig. 14 is the same as the construction of the horns shown in Figs. 8-13 very clearly appears from the following statement made with respect to Fig. 14 (T., p. 390):

“The sheets of veneering, thus maintained, can effect the forms desired, by varying the form of the skeleton and ribs and shape of the sheets of wood”.

It is also said that the horn of Fig. 14 is “*bell-shaped*” and that “*the strips of wood B*” are secured, at one end, in the envelope carried by the metal mouth-piece or stem E, and, at the other end, in the “*bell ring*” A.

Furthermore it is very clear, from what follows under Turpin’s description of his 4th method of constructing horns for phonographs, that the curved or bell-shaped horn shown in Fig. 14, may be composed of *12 strips, of wood and of metal*, the strips of metal, where *two* are employed, being put in opposition to each other, one on one side of the horn and the other on the opposite side of the horn.

The description of Turpin’s French patent is so clear that no explanation outside of the specification

and drawings is necessary to understand it. However, experts in the manufacture of horns have testified with regard to it (Affidavits, T., pp. 64-65, 92-94, 105, 111-112, 120-121, 136; compare patents, T., pp. 310, 362, 373, 304, 354).

In order to show, without extended argument, the construction and shape of the curved or bell-shaped horn of Fig. 14 of Turpin's French patent, appellant's counsel has had a *model horn* made in accordance therewith, for use at final hearing.

Since Turpin pointed out that horns for phonographs should be constructed *of strips of wood instead of metal, or from strips of wood combined with strips of metal*, it involved no invention on Nielsen's part to construct the *same horn*, according to the *same method*, from strips of metal instead of strips of wood. The authorities clearly show that, in such cases, *the mere substitution of material does not involve invention* (See authorities cited, *infra*, pp. 72-73).

Expert manufacturers of horns testify, and the patents in evidence show, that the use of metal for wood, or wood for metal, in the manufacture of horns for phonographs from tapering strips, was continuously practiced in the prior art (Affidavits, T., pp. 64-65, 92-94, 105, 111-112, 120-121, 136; patents, T., p. 362, lines 32 *et seq.*; pp. 383-386; *infra*, pp. 71-72).

2. *British patent No. 20,146 of September 15, 1902, to Villy (T., p. 349).*

This patent was not before the District Court in the action at law or suit in equity against Sherman, Clay & Co. U. S. patent No. 739,954 of September 29, 1903, to Villy (T., p. 302), was before the court; but the British patent differs from the U. S. patent, especially in that the British patent in Fig. 8 (T., p. 355)

shows, in detail, the form of *each* section of the bell of the horn.

Fig. 8 of the Villy British patent shows the precise form of the tapering strips with curved sides, which the District Court held, and plaintiff's counsel contends, is the essence of Nielsen's alleged invention of the patent in suit. Nielsen merely made the strips of metal, while Villy stated that he made the strips of Fig. 8 "of paper, wood, linen, or other preferably flexible material" (T., p. 351, lines 5-6), which in this art included metal and all other known equivalent flexible materials (supra, pp. 22-24; infra, pp. 71-72).

Reference to Fig. 5 (T., p. 354) of the British Villy patent, shows that the Villy horn consisted of a conical part *l* at the small end of the horn and of a bell-shaped part at the large end of the horn. The horn of Fig. 1 of the Nielsen patent in suit is nothing but the horn of Fig. 5 of the Villy patent, except that the ribs or ridges of the Nielsen horn consist of the two outwardly-directed flanges joined together as heretofore explained. The following description of the Villy horn shows that this is so.

Describing his horn, Villy says:

"I make the end *a* of trumpet-like or curved configuration with an enlarged outer end and a smaller end at the interior of conoidal-like form. I make this enlarged and trumpet-like device by employing a series of strips *b* of paper, wood, linen, or *other preferably flexible material*, the foundations of which I prefer to make of linen or the like so as to form a hinge-like connection *c* between each of the strips * * *" (T., p. 351, lines 3-8).

"The angles formed by the meeting of the hinged segments, when extended, form, as it were, *ribs* giving rigidity to the trumpet form" (T., p. 351, lines 16-18).

Plaintiff's expert, Mr. Vale, testified in the action at law against Sherman, Clay & Co. (T., p. 191; and Transcript in No. 2036, p. 110):

“Q. What is your impression of a seam, your definition, your mechanical definition of a seam?”

A. It would be that portion of any two edges joined together.

Q. How does a rib differ mechanically from a seam?

A. Well, *a rib is a thickening in cross sections within narrow longitudinal limits of the body of any material. It might be an overlapping of that material, or it might be an integral thickening of it and still be a rib.*

The Court: Q. *There might be a rib without a seam?*

A. *Yes.*

Q. And a seam might be so constructed as to constitute a rib?

A. *Yes.*

Mr. Acker: Q. Is it your understanding that any seam that has any thickening of the metal constitutes a rib?

A. To a certain extent, yes, if there is an over-lapping of the body of the two joined parts.”

In Fig. 6, Villy shows the lock seam of defendant's horns, for joining together the edges of two of the strips (T., p. 355; p. 351, lines 22-31).

Thus, Villy provided his horn with longitudinal ribs, extending from one end to the other end of the body of the horn, on the outside thereof.

The cone *l* of Fig. 5, at the small end of the horn, Villy says, may be made of one piece (T., p. 351, line 44), as in defendant's horns.

Further describing his horn, Villy says (T., p. 352, lines 12-16):

“my collapsible horn could not be made up from a single flat sheet, as each strip has to be made

with *curved edges*, and when the strips are flexibly secured together at such curved edges the whole or complete surface so formed cannot be laid out or developed on a flat surface. My horn, owing to the curvature of the edges of the strips, is self-sustaining and requires no additional stiffening or sustaining devices
* * *.”

Finally, Villy says (T., p. 352, lines 25-29):

“I do not limit the application of my invention to any particular method of building up the segments or to any special curve or configuration of the same, and *I vary the method of jointing* and stiffening them *to suit the material* from which the strips are constructed, and the foundation or base fabric upon which the *flexible material* forming the strips is secured”.

Claim 3 of the Villy patent reads as follows (T., p. 352):

“3. A phonograph horn, ear trumpet or the like comprising *a rigid conical tube* and a collapsible trumpet-shaped mouth telescoped thereon or otherwise secured thereto, *such mouth being made up of a number of flexible strips having curved meeting edges* and flexible connections at such edges, substantially as herebefore described”.

It is evident that Villy made his horn of any suitable flexible material; that the joining of the strips, having curved meeting edges, formed “ribs giving rigidity to the trumpet form”; and that he varied the method of joining and stiffening the strips to suit the flexible material forming the strips. Undoubtedly, Villy contemplated the use of *metal* as well as the use of paper, wood or any other flexible material.

Defendant’s Edison straight horn is clearly the horn of Fig. 5 of the Villy patent.

The prior art shows that the use of the tinsmith's or lock-seam for joining together strips or sections of metal was well known. Of course, when paper or wood was employed some other method suitable for such material had to be employed. This principle is expressly stated in the part above quoted from the Villy patent. As shown by the affidavits of expert manufacturers of horns and by the patents of the prior art in evidence, whenever metal was employed, one of the well-known seams for joining strips of metal was employed and such seams formed longitudinal ribs on the outside of the horn (Affidavit, T., p. 63-65, 72, 76, 80, 87-89, 94-95, 108-110, 112-123, 124-125, 127-129, 130-140; patents, T., pp. 235, 243, 246, 255, 258, 294).

Mr. Walter H. Miller shows that defendant's Edison horns are made according to the Villy patent (T., pp. 116-117).

It is entirely immaterial that Villy so constructed his horn that it was collapsible. *Nielsen makes no specification whatsoever in the patent in suit as to how the tapering strips of his horn are to be secured together.* He does not say that they are to be soldered together, or riveted together, or how they are to be secured together. He does not say that his horn is a rigid horn or a collapsible horn. The claims of the Nielsen patent in suit read upon the horn of the Villy patent, and are therefore anticipated by it, unless claims 2 and 3 of the Nielsen patent are to be limited to the outwardly-directed flanges, joined together to form longitudinally-arranged ribs on the outside of the horn.

In the United States, Villy obtained a reissue of his patent No. 739,954 of September 29, 1903, the reissue being No. 12,442 of January 30, 1906, (See Record in Sherman, Clay & Co. action at law, No. 2306, pp. 127-128). The plaintiff, the Searchlight

Horn Co., manufactured horns under the Nielsen patent in suit and under the Villy reissue patent and marked them with the dates of both patents (See Record in the action at law against Sherman, Clay & Co., No. 2306, pp. 89-90). The only substantial difference between the original United States Villy patent and the reissue thereof is that the reissue contains 14 claims while the original had only 7 claims. Of course, the manufacture and sale by plaintiff of horns marked with the dates of the Nielsen and Villy patents was *an admission*, on the part of plaintiff, that the horn of the Villy patent comprised horns made of metal as well as of other flexible material. It is true that the District Court ruled out the Villy reissue patent, but it was clearly competent evidence to establish this admission on the part of plaintiff. The Villy reissue patent and a horn marked "Z", put out by plaintiff under the Nielsen and Villy patents and marked with the dates thereof, are to be found among the exhibits in the action at law against Sherman, Clay & Co., (See Record, No. 2306, pp. 89, 128).

The affidavit of Camillus A. Senne also shows that the United States Horn Company, plaintiff's predecessor in title to the Nielsen patent, took the position that horns made of paper infringed the Nielsen patent (T., pp. 130-149).

Under well-settled law "that which infringes if later, anticipates if earlier", *Knapp v. Morse*, 150 U. S., 221, 228). Plaintiff stands in the shoes of the former owner of the Nielsen patent (*Woodmanse Co. v. Williams*, 68 Fed., 489, 492). Hence, beyond all question, the French patent to Turpin and the United States and British patents to Villy anticipate claim 3 of the Nielsen patent in suit and also anticipate claims 1 and 2 thereof unless claims 1 and 2 are limited to the outwardly-directed flanges, as above explained.

3. *United States patents No. 453,798 of June 9, 1891, and No. 491,421 of February 7, 1893, to Gersdorff (T., pp. 255, 258).*

The patents to Gersdorff were not before the District Court in the action at law or in the suit in equity against Sherman, Clay & Co.

The Gersdorff patents are clear anticipations of claim 3 of the Nielsen patent in suit and of claims 1 and 2 thereof unless claims 1 and 2 are limited as above specified.

Gersdorff shows a horn or funnel constructed of a number of tapering strips of metal, joined together at their edges by tinsmith's or lock seams which form longitudinal ribs extending from one end to the other end of the horn or funnel and on the outside thereof, *as in defendant's horns.*

Reference to Fig. 2 of the Gersdorff patent 491,421 (T., p. 258) shows this construction. It will be observed that the horn or funnel curves outwardly to form a flaring or bell-shaped large end; and that the strips necessarily curve along their meeting edges in order to secure this shape of the horn or funnel.

In the Gersdorff patent No. 453,798, it is said that the horn or funnel "*may consist of two, three or more*" sections (T., p. 256, lines 50-51).

The construction of the Gersdorff horn or funnel is set forth in patent No. 491,421 as follows (T., p. 259, lines 36-49):

"My funnel A is formed from two or more—preferably three—sections a and a which are united upon longitudinal lines so that each section extends from the upper end to the lower end of the funnel and constitutes a part of the body and a part of the nozzle of the same, as shown. The joints or seams are all lengthwise of the funnel, and in the direction of the great-

est strain—transversely—said funnel presents only solid metal which is strengthened by its curved form and by said seams, and is capable of resisting successfully a much greater force than would ever be exerted by any proper use”.

Gersdorff further says (T., p. 259, lines 72-93):

“As hereinbefore stated, *the funnel is made wholly of longitudinal sections which extend from the top of the body of the funnel to the lower end of the nozzle.* The parts of the sections which form the body of the funnel are each made segmental in cross-section, and the lower parts of said sections which form the nozzle are flattened. *The sections are united together along their side edges through the body of the funnel by bending the same to form flanges and by interlocking and soldering the flanges together, thus forming the longitudinal seams; but in the nozzle, the sections are united by soldering instead of interlocking the flanges, thus forming smooth seams in the nozzle.* The segmental portions at the upper ends of the sections form the body of the funnel which body is circular in cross section; and the flattened lower portions of said sections form the nozzle which is triangular in cross section, as shown in the drawings”.

In claims 1 and 2 Gersdorff describes the material construction as follows (T., p. 260):

“As a new article of manufacture, a funnel made of longitudinal sections united together by means of longitudinal seams, and each section forming a part of the body and nozzle of the funnel”.

That a horn is a funnel and that a funnel is a horn is self-evident. It is so stated in the Villy patents (T.,

p. 351, lines 46-55). It requires no adaptation of a funnel to use it as a horn for a phonograph. *The evidence of expert manufacturers of horns for phonographs shows that the funnel of the Gersdorff patents is, in fact, a horn adapted, without any modification whatsoever, for use with a phonograph for the reproduction of sound from a sound-record* (T., pp. 94-95, 118-119, 157).

In order to show, without extended argument, the construction and shape of the curved or bell-shaped horn or funnel of the Gersdorff patents, appellant's counsel has had made, for use at final hearing, two model horns, in accordance with the drawings and descriptions of the Gersdorff patent, one with three, and the other with eight, tapering strips of metal joined together at their edges with tinsmith's or lock seams, forming longitudinal ribs on the outside of the horn, as in defendant's horns.

Nielsen was not the first to discover that a horn was a funnel or that a funnel was a horn; nor was he the first to discover that a funnel could be used as a horn for a phonograph. If, contrary to the fact, Nielsen had been the first to use a funnel for a horn, he could not have obtained a valid patent for such use of Gersdorff's funnel or horn, since it required no change whatever in Gersdorff's funnel or horn to use it in connection with a phonograph.

The decided cases show that in such a case it is immaterial whether or not the old device has met with commercial success in its new field of use (see cases cited in the next paragraph).

The following cases show that *where an old device is adapted, without change or with a very slight change that would occur to any skilled mechanic, to perform a new use for which it was not originally intended, no invention is involved in using the old device for the*

new use (*Excelsior Drum Works v. Sheip & Vandegrift*, 180 Fed., 980, 982; *Codman v. Amia*, 70 Fed., 710; *Stearns & Co. v. Russell*, 85 Fed., 218, 229-230; *Daylight Co. v. American Co.*, 142 Fed., 454, 461; *Voightmann v. Weis Co.*, 148 Fed., 848, 853; *Wayne Mfg. Co. v. Benbow Co.*, 168 Fed., 271, 277; *Acme Co. v. Meredith*, 183 Fed., 124, 125; *Weir Co. v. Porter*, 206 Fed., 670, 674-676).

In the *Stearns & Co.* case (*supra*) Judge TAFT said (85 Fed., 230) as follows:

“The cases in which it has been held that an old machine applied to a new purpose is not a new patentable machine are so numerous that it would take too much space to cite them all”.

In the *Weir Co.* case (*supra*) Judge DENISON, quoting, said (206 Fed., 674):

“But this function was dormant in the (device of the prior art). Surely invention cannot be claimed in the appropriation of an old device, by reason of the unthought of and undisclosed function in question”.

It is equally well-settled that anticipation cannot be avoided by showing the presence, in the anticipating device, of elements which would not obviate infringement of the claims of the patent (*Standard Co. v. Rambo & Regar*, 181 Fed., 157, 162).

4. Trade-mark No. 31,772, registered July 5, 1898, by John Kaiser, for the “Kaiser horn” (*T.*, p. 100); and Kaiser’s horn of 1898 from which the drawing of the trade-mark was made, and photograph of the horn (*T.*, p. 102).

Neither the Kaiser trade-mark nor the Kaiser horn was before the District Court in the action at law or in the suit in equity against Sherman, Clay & Co.

The Kaiser horn is a complete anticipation of claim 3 of the Nielsen patent in suit, in any view. Its shape is shown in the drawing of the trade-mark (T., p. 100). Its construction is shown by the horn from which the drawing of the trade-mark was made and by the photograph of that horn set forth in the Record (T., p. 102).

The Kaiser horn was first made by Mr. Kaiser in November, 1895. It consisted of twelve tapering strips of tough, leather-like paper, secured together at their edges by lap seams and glue, thus forming longitudinal ribs extending from one end of the horn to the other. The shape of the Kaiser horn is precisely the shape of the horn shown in Fig. 1 of the Nielsen patent in suit. To use the language of Judge Van Fleet's charge to the jury in the action at law against Sherman, Clay & Co., the strips of the Kaiser horn "curve outwardly from the inner to the outer end, but the curve is more abrupt adjacent the outer end"; and the horn is "larger at one end than the other and having substantially a bell-shape and abruptly flaring outlet made up of longitudinally-arranged metal (paper) strips secured together at their outer edges by a seam of such character as to produce longitudinal ribs on the outer surface" (Transcript of Record in No. 2306, p. 273; *supra*, p. 34).

As hereinafter fully shown (*infra*, pp. 65-67), the prior art employed every variety of seams for joining together the edges of tapering strips of flexible, sheet material composing horns for phonographs, including the lap-seam used in the Kaiser horn, the tinsmith's or lock seam used in defendant's horns and a large number of other seams, all of which formed longitudinal ribs extending from one end of the horn to the other.

In British patent No. 22,612 of April 15, 1899, to Hogan, such a seam forming a longitudinal rib is

shown in Fig. 5 (T., p. 322). The use of the seam and of the longitudinal rib formed thereby, for joining together the edges of the tapering strip and to augment and improve the sounding qualities of the trumpet, is described in the said Hogan British patent as follows (T., p. 320, lines 15-22):

“The trumpet is made of a sheet of tough paper or thin indurated fibre, and each of the two edges of this material that come together when the sheet is folded to the cone form are first bordered by a thin sheet-metal strip folded longitudinally, as shown at *h* in Fig. 5. This metal strip encloses the sheet-edge like a clip and *extends from the large end to the point end*. The two metal strips are abutted together and joined by solder. *This metal strip not only serves as a means of joining the sheet-edges, but also serves to augment and improve the sounding qualities of the trumpet*”.

French patent No. 321,507 of May 28, 1902, to Runge, shows in Fig. 2 (T., p. 395), the use of a seam or rib G^1 , which is exactly like the rib or seam *h* shown in Fig. 5 of the British patent to Hogan (T., p. 322). In the French patent, however, Runge states that the crease G^5 of Fig. 2, may be eliminated and that more than two longitudinal reinforcements like the seam or rib G^1 may be employed (T., p. 399, par. 1). And in claim 1 of his French patent, Runge states that the two or more longitudinal reinforcements or ribs G^1 serve to improve the sound-producing qualities of the horn, claim 1, reading as follows (T., p. 400):

“1st. In a graphophone or talking machine, a horn having *two or more* longitudinal reinforcements, serving to *improve its sound-producing qualities*”.

We thus see that the use of *any* kind of seam, forming a longitudinal rib extending from one end of the horn to the other, and serving not only to join together the adjacent edges of the tapering strips of suitable material, composing the horn, but also to strengthen the horn and to augment and improve the sound-producing qualities of the horn, was old in the art. The various seams and the various longitudinal ribs formed thereby were known equivalents. So also cardboard, celluloid, leather, paper, metal; in fact, all flexible sheet materials were known equivalents in the prior art, as suitable materials from which to form tapering strips to be used in the construction or building up of a horn *of any design, shape or form*.

Mr. Kaiser, after stating that he first made the Kaiser horn in October or November, 1895, describes the Kaiser horn and shows that it anticipates the horn of the Nielsen patent in suit as follows (T., pp. 86-89):

“The Kaiser horn referred to was made of twelve tapering strips of tough leather-like paper, which overlapped and were glued together at their edges forming longitudinal seams or ribs extending from one end of the horn to the other and strengthening and reinforcing the horn.

“On April 14, 1898, I filed an application for the registration of a trademark, to wit ‘Kaiser Horn’, in connection with an illustration of the horn, and set forth that this trademark had been continuously used in my business since September 1, 1897, which statement was correct. Upon this application trademark No. 31,772, registered July 5, 1898, was issued to me, and I annex to this affidavit a copy of the said trademark. I have preserved the Kaiser horn from which the drawing of the horn shown in said trademark No. 31,772 was made;

and I have submitted this horn to Mr. Louis Hicks, counsel for defendant herein, and I annex hereto a photograph of said horn designated 'Kaiser Horn of 1898'. It will be seen from an inspection of the horn itself and of the photograph thereof that the horn was made in the manner above described. It will be noticed also that the said horn, the photograph thereof and the drawing thereof in said trademark all show that the Kaiser horn was narrow at the small end and flaring at the large end and bell-shaped, the tapering strips of which the horn was made curving gradually outwardly from the small end to the large end of the horn. I am familiar with the Nielsen patent No. 771,441, of October 4, 1904, and the drawings thereof. *I can see no difference between the horn shown and described in the Nielsen patent and my Kaiser horn made as stated above in October or November, 1895. The Nielsen horn and the Kaiser horn are each made of tapering strips secured together at their edges so as to form seams or ribs extending longitudinally along the horn from one end of the horn to the other.* In each case the ribs serve to strengthen and reinforce the horn. I preferred to make the Kaiser horn of a tough leather-like material, because, in my opinion, such material gave a better reproduction of sound. Metal has a vibration that is sympathetic with certain musical notes, and this sympathetic vibration of the metal gives a blasting of the high notes. I therefore made the Kaiser horn of tough leather-like paper since such material and material such as wood give to the reproduction of sound a mellow musical quality and are particularly good in reproducing the detail of a phonograph record. *The shape of the Nielsen horn is a copy of the shape of the Kaiser horn.* Since I employed paper instead of metal it was advantageous to secure

together the edges of the tapering strips by means of some adhesive substance such as glue. Had I employed tapering metal strips to make the Kaiser horn I should have employed one of the well-known tinsmith's seams such, for instance, as the lock seam then in common use in the construction of phonograph horns, for joining together the edges of the tapering metal strips. In 1895 and for several years prior thereto, and prior to the year 1903, it was common to make horns for phonographs of different materials such as metal, wood, celluloid, paper, glass, etc. The bell-shaped horn was well known, and so was the construction of the bell-shaped horn from tapering strips joined together at their edges so as to form longitudinal ribs or seams extending from one end of the horn to the other, said tapering strips curving outwardly from the small end to the large end of the horn. *The method of joining the edges of the tapering strips together necessarily depended more or less upon the material of which the tapering strips consisted.* It was common practice for many years prior to 1903, in this country, to substitute one material for another in the making of horns for phonographs and similar instruments and to join the edges of the strips of material forming the horn in any of the many well-known ways for so doing, all of which ways were equivalent to one another. *If the strips of which the horn was composed consisted of wood, paper or celluloid an adhesive substance might be used which substance was in no way different from the solder employed when the strips were of metal.* An examination of the French, English and United States patents adduced by defendant's counsel in this suit and shown to me by him will illustrate what I mean without the necessity of my referring with any particularity to any one or more of the patents. I did not apply for a

patent on the Kaiser horn, and sought protection therefor by registration of my trademark only, because I was advised by my attorney at the time that, in view of the state of the art, it was not patentable invention to construct a horn of tapering strips secured together at their edges in the manner described, so as to form longitudinal seams or ribs reinforcing and strengthening the horn, the said strips curving gradually outwardly from the small end to the large end of the horn so that the horn was narrower at the small end and flaring at the large end and of bell-shape, the horn being made of a tough leather-like paper instead of the usual metal employed in order to improve the sound-producing qualities of the horn."

5. *Plaintiff's contention that the tinsmith's or lock-seam, employed in defendant's horn, as it was in Emerson's horn of 1898 (T., p. 196), and in Miller's and Meecker's horn of 1897 (T., pp. 124, 125), and in the horns or funnels of the Gersdorff patents of 1891 and 1893 (T., p. 255, Fig. 3; p. 258, Fig. 2), is the equivalent of the butt seam, shown in Figs. 1 and 3 of the Nielsen patent in suit (T., p. 28), consisting of two outwardly-directed flanges connected to form the ribs b², establishes the equivalency of the lap-seam of the Kaiser horn and the butt seam of the horn of the Nielsen patent in suit. Hence the claims of the Nielsen patent in suit necessarily fall by reason of anticipation by the Kaiser horn.*

This proposition is established by the opinion of the Circuit Court of Appeals in *Wilson v. McCormick*, 92 Fed., 167, 175, where it is said:

"We are of opinion, further, that the reasoning by which it has been sought to show equivalency between the McCormick machine

and that of the patent will establish a *like equivalency* for the parts and combination of the "Advance Mower"; and, that done, the patent falls by reason of anticipation".

It is an untenable proposition that defendant's tin-smith's or lock-seam is the equivalent of Nielsen's butt seam, formed by connecting two outwardly-directed flanges, and that all the seams of the prior art, that were known to be equivalents of defendant's seams, are not equivalents of the butt seam of the Nielsen patent in suit. Either the three claims of the Nielsen patent are invalid or they are limited by the butt seam, consisting of two outwardly-directed flanges connected together, *in which case, defendant does not infringe.*

6. *The curved or bell-shape of the horn, shown in Fig. 1 of the Nielsen patent in suit, is as old as the hills. It formed no part of Nielsen's invention, and he made no claim for it. It is shown in "Horns for Phonographs," described in numerous patents of the prior art and has been employed in musical instruments since the days of the Roman Empire.*

The curved or bell shape of the horn, shown in Fig. 1 of the Nielsen patent in suit, is shown in the following patents of the prior art:

U. S. trade-mark No. 31,772 of July 5, 1898, to Kaiser (T., p. 100).

Photograph of Kaiser's horn of 1898 (T., p. 102).

Kaiser's horn of 1898, from which the photograph was taken (T., p. 87; and the horn itself).

U. S. patent No. 491,421 of Feb. 7, 1893, to Gersdorff (T., p. 258, Fig. 2).

U. S. patent No. 534,543 of Feb. 19, 1895, to Berliner (T., p. 263, Fig. 3).

U. S. patent No. 647,147 of April 10, 1900, to Myers (T., pp. 277-278, Figs. 1-4).

U. S. patents No. 34,907 of Aug. 6, 1901 (design, T., p. 235, Figs. 1-3) and No. 699,928 of May 13, 1902 (T., p. 294, Figs. 1-4), to McVeety and Ford.

U. S. patent No. 739,954 of Sept. 29, 1903, to Villy (T., p. 304, Fig. 5).

British patent No. 20,146 of Sept. 15, 1902, to Villy (T., p. 354, Fig. 5).

French patent No. 318,742 of Feb. 17, 1902, to Turpin (T., p. 381, Fig. 14).

Reference to any standard encyclopedia, published prior to the date of Nielsen's alleged invention, will show that the curved or bell-shaped horn has been used in musical instruments for centuries (See the 9th edition of the Encyclopedia Britannica, published prior to 1890, under "TRUMPET"; or the Encyclopedic Dictionary, published in Philadelphia in 1894, under the heads of "TROMBONES", "TRUMPETS", and "CORNET-A-PISTON").

The 11th edition of the Encyclopedia Britannica gives illustrations of curved or bell-shaped horns used centuries ago. Under the head of "HORN", Fig. 6, shows a bell-shaped horn, published in an edition of Virgil in the year 1502. Fig. 7, shows a like bell-shaped horn, described in 1870, as having been made by Raoux, early in the 18th century. Fig. 8, shows a like bell-shaped modern horn made by Boosey & Co. Similar bell-shaped horns are shown under the heads of "TRUMPET", "TROMBONE", "CORNET", "CLARINET", "TUBA", etc. Under the head of "BELL", it is said that the bells made in 1091 or before were not cast but were made of thin iron plates, hammered and riveted together. These early bells were small bells, six inches high, five inches wide and 4 inches deep.

Under the head of "HORN", it is said:

"The origin of the horn must be sought in remote prehistoric times, when, by breaking off the tip of a short animal horn, one or at best two notes, powerful, rough, unsteady, only barely approximating to definite musical sounds, were obtained. This was undoubtedly the archetype of the modern families of brass wind instruments, and from it evolved the trumpet, the bugle and the tuba, no less than the horn. The common characteristics which link together these widely different modern families of instruments are: (1) the more or less pronounced conical bore, and (2) the property possessed in a greater or lesser degree of producing the natural sounds by what has been termed overblowing the harmonic overtones. If we follow the evolution of the animal horn throughout the centuries, the ultimate development leads us not to the French horn but to the bugle and tuba.

"Before civilization had dawned in classic Greece, Egypt, Assyria and the Semitic races were using wind instruments of *wood* and *metal* which had left the primitive ram or bugle horn far behind" (p. 700).

"Among the Romans the wind instruments derived from the horn were well represented, and included well developed types which do not differ materially from the natural instruments of modern times" (p. 700).

"We know from the colouring used in illuminated MSS., gold and pale blue, that horns were made of *metal* early in the middle ages. *The metal was not cast in moulds but hammered into shape.* Viollet-le-Duc reproduces a miniature from a MS. of the end of 13th century (Paris, Bibliothèque du corps législatif), in which two metal-workers are shown hammering two large horns" (p. 701).

“There is evidence, however, that a century earlier, *i. e.*, at the end of the 15th century, the art of bending a brass tube of the delicate proportions of the French horn, which is still a test of fine workmanship, had been successfully practised. In an illustrated edition of Virgil’s works published in Strassburg in 1502 and emanating from Grüninger’s office, Brant being responsible for the illustrations, the lines (*Aen.* viii. 1-2) ‘Ut belli signum Laurenti Turnus ab arce Extulit: et rauco strepuerunt cornua cantu’ are illustrated by two soldiers, one with the sackbut (posaune, the descendant of the buccina), the other with a horn wound spirally round his body in three coils, which appear to have a conical bore from the funnel-shaped mouthpiece to *the bell* which extends at the back of the head horizontally over the left shoulder (fig. 6)”, (p. 702).

“Dr. Julius Rühlmann states that there are two horns by Raoux, bearing the date 1703, in the Bavarian National Museum in Munich, but although fine examples, one in silver, the other in brass (fig. 6) by Raoux, they turn out on inquiry to bear no date whatever” (p. 702).

The curved or bell-shape of a horn being therefore centuries old, it is not surprising that horns for phonographs were made of a shape conforming therewith; nor is it surprising that Nielsen made no attempt to claim such a shape of horn; nor is it surprising, as shown above (*supra*, pp. 15-21), that neither the Patent Office nor Nielsen regarded the curved or bell-shape of the horn as forming any feature whatever of the invention which Nielsen was attempting to patent.

7. U. S. patent No. 34,907 of August 6, 1901, to McVeety & Ford for a design (T., p. 235) and U. S. patent No. 699,928 of May 13th, 1902, to McVeety (T., p. 294).

These patents show a ship's ventilator in the form of the bell or large end of a horn. The ventilator is composed of 8 tapering sections of metal, having curved meeting edges, with outwardly-directed flanges, which are connected together to form longitudinal ribs extending from one end of the horn or ventilator to the other, *according to the precise construction shown in Figs. 1 and 3 of the Nielsen patent in suit, for forming the longitudinal ribs on the outside of the horn.*

Horns for phonographs have been made in the shape of the ventilator, shown in the McVeety & Ford patents, the usual funnel *l*, shown in Fig. 5, of the Villy patent (T., p. 304), having been annexed to the smaller end of the ventilator. Such horns are used in cabinet machines, the horn being concealed in the cabinet. Such cabinet machines are shown in the catalogue of "Edison Phonographs", introduced in evidence by plaintiff.

The three claims of the Nielsen patent in suit read upon the ventilator of the McVeety & Ford patents. The similarity is not merely verbal; it is substantial. The ventilator shows the body portion of a horn, and that is what claims 1 and 2 of the Nielsen patent claim. It is not necessary to change the ventilator, in any way, whatsoever, to form the body portion of a horn for a phonograph. It is adapted for use as the body portion of a horn for a phonograph, without modification. Therefore, as shown above (*supra*, pp. 15-24), it is an anticipation of the claims of the Nielsen patent, since, where an old device is adapted, without change,

to perform a new use for which it was not originally intended, no invention is involved in using the old device for the new use (See cases cited *supra*, pp. 50-51).

The Court's attention is requested to the McVeety & Ford patents, since every feature of the three claims of the Nielsen patent in suit is shown therein.

McVeety & Ford say that "the general contour of the ventilator is that of a *curved tapering figure*" (T., p. 236, lines 22-23).

The sections are tapering sections, with curved-meeting edges. The curved meeting edges are bent outwardly so as to form outwardly-directed flanges, by means of which the sections are joined together in a manner to form longitudinal ribs, extending from one end to the other of the ventilator upon the outside thereof.

This is Nielsen's horn, not as Nielsen *claimed* it, but as plaintiff's counsel, in an effort to avoid anticipation, *now* contends Nielsen claimed it. Nielsen could not patent a new use of an old device; and he cannot, therefore, prevent others from using this old device of the McVeety & Ford patents, for *any* use for which it is adapted. The fact that the tapering strips on one side of the ventilator are prolonged is entirely immaterial.

In order to show, without extended argument, the construction and shape of the McVeety & Ford ventilator, appellant's counsel has had constructed a model of the ventilator for use at final hearing. This model has attached to it, at the smaller end, the funnel or conical piece *l* shown in Fig. 5 of the Villy patent (T., p. 304).

NIELSEN PRODUCED NO NEW COMBINATION OF ELEMENTS. HE EMPLOYED NO NEW ELEMENT. HE DISCOVERED NO NEW FUNCTION. HE PRODUCED NO NEW

RESULT. ALL THAT HE DID WAS TO COMBINE, IN A WELL-KNOWN WAY, BY MEANS THAT WERE OLD, A NUMBER OF TAPERING STRIPS OF THE EXACT FORM AND SHAPE OF STRIPS OF THE PRIOR ART, TO FORM A HORN OF A SHAPE THAT WAS OLD IN THE PRIOR ART. THE MATERIAL THAT HE USED AND THE SEAMS AND RIBS THAT HE USED WERE ALL OLD AND WERE THE KNOWN EQUIVALENTS OF NUMEROUS OTHER MATERIALS, SEAMS AND RIBS THAT WERE USED IN THE PRIOR ART.

1. The construction of horns for phonographs from tapering strips of flexible material, having curved meeting edges, was old in the prior art.

United States Patents.

No. 34,907 of August 6, 1901, to McVeety & Ford (T., p. 235).

No. 491,421 of February 7, 1893, to Gersdorff (T., p. 258, fig. 2).

No. 699,928 of May 13, 1902, to McVeety & Ford (T., p. 294).

No. 739,954 of September 29, 1903, to Villy (T., p. 304).

British patent.

No. 20,146 of September 15, 1902, to Villy T., p. 354, fig. 5; p. 355, fig. 8).

French patent.

No. 318,742 of February 17, 1902, to Turpin (T., p. 381, fig. 14; cf. p. 380, fig. 8).

Affidavits (T., pp. 57-74; 75-77; 78-83; 84-105; 107-125; 130-140).

As shown by the references, the strips composing the horns of the Villy, Turpin, Gersdorff and McVeety

& Ford patents and composing the Kaiser horn are the strips employed by Nielsen in making the horn of the patent in suit. Such strips were made of any suitable, flexible sheet-material, including metal.

2. *The curved or bell-shape of the horn shown in Fig. 1 of the Nielsen patent in suit was old in the horns of the prior art. Horns having such shape were built up, in the prior art, from tapering strips of suitable, flexible sheet-material, including metal, having curved meeting edges and forming longitudinal ribs on the outside of the horn.*

This appears from the patents above cited (*supra*, pp. 64-65) and from what has heretofore been said in this brief.

The horns of the Turpin, Gersdorff, McVeety & Ford and Villy patents and the Kaiser horn are sufficient illustrations.

The affidavits of Hawthorne, George and Stewart (T., pp. 57-74, 75-77, 78-83) show that Hawthorne & Sheble manufactured such horns in this country, prior to the date of Nielsen's alleged invention.

3. *Innumerable patents of the prior art show that the sides of the tapering strips of suitable, flexible sheet-material, employed for building up horns for phonographs, were joined together by every variety of seams, thereby forming longitudinal ribs upon the outside of the horn, extending from one end to the other of the horn.*

The following patents show ribs upon the *inside* and *outside* of the horn, as in defendant's horn, to-wit:—

British Patents.

No. 22,612 of 1889 to Hogan (T., p. 322, *h* of fig. 5).

No. 7,594 of 1900 to Hogan (T., p. 330, figs. 5 and 6).

No. 9,727 of 1901 to Runge (T., p. 337, N¹ of fig. 2).

No. 22,273 of 1901 to Runge (T., p. 341, B of figs. 2 and 3).

French Patents.

No. 318,742 of Feb. 17, 1902 to Turpin (T., pp. 380-381, figs. 9-13).

No. 321,507 of May 28, 1902, to Runge (T., p. 395, G¹ of figs. 1 and 2).

No. 331,566 of April 28, 1903, to Hollingsworth, (T., p. 404, a⁵ of figs. 1-5).

United States Patents.

No. 453,798 of June 9, 1891, to Gersdorff (T., p. 255, figs. III and V).

No. 491,421 of Feb. 7, 1893 to Gersdorff (T., p. 258, figs. 2 and 5).

No. 632,015 of August 29, 1899, to Hogan (T., p. 274, *h* of fig. 5).

No. 648,994 of May 8, 1900 to Porter (T., p. 282, a² b² of fig. 1).

No. 692,363 of Feb. 4, 1902 to Runge (T., p. 280, N¹ of fig. 2).

French patent No. 321,507 of May 28, 1902, to Runge (T., pp. 393, 397) states that the metal clip or strip G¹ may be upon the exterior or upon the interior of the horn and that one may employ *more than two* of these clips or strips as reinforcements (p. 399, par. 1); and in figs. 1 and 2 of this French patent Runge shows a metal clip or strip G¹ composed of two U shaped pieces of metal soldered together and provided, therefore, with two U shaped sockets which

receive the edges of the sheet material in order to join the same together at their edges and thus form longitudinal ribs both upon the inside and upon the outside of the horn.

The following patents of the prior art show longitudinal ribs upon the *outside* of the horn only, to-wit:—

British Patents.

No. 17,786 of 1902 to Fairbrother (T., p. 347, *k* and *k*¹, figs. 6 and 7).

No. 20,146 of 1902 to Villy (T., p. 353, figs. 1 and 5 and 6 and page 351, lines 16-18 and 22-29).

No. 20,567 of 1902 to Tourtel (T., p. 361, fig. 4).

United States Patents.

No. 8,824 of December 7, 1875, to Shirley (T., p. 231, Design).

No. 10,235 of September 11, 1877, to Cairns (T., p. 233, Design).

No. 34,907 of August 6, 1901, to McVeety, *et al.*, (T., p. 235, Design, B of figs. 1-3).

No. 165,912 of July 27, 1875, to Barnard (T., p. 239, *d* of fig. 5).

No. 406,332 of July 2, 1889, to Bayles (T., p. 246, E of fig. 2).

No. 409,196 of August 20, 1889, to Hart (T., p. 249, *g* of fig. 8).

No. 534,543 of February 19, 1895, to Berliner (T., p. 263, fig. 3).

No. 699,928 of May 13, 1902, to McVeety *et al.* (T., p. 294, B of figs. 1-3).

No. 748,969 of January 5, 1904, to Melville (T., p. 307, *c* of fig. 1).

No. 763,808 of June 28, 1904, to Sturges (T., p. 310, fig. 2 and p. 311, lines 53-58).

4. Nielsen's claim that the longitudinal ribs b^2 , of the horn shown in Figs. 1 and 3 of the patent in suit, improve the sound-producing qualities of the horn was anticipated in the prior art. The evidence of experts in the art, however, shows that the claim is entirely without foundation.

In British patent No. 22,612 of April 15, 1899, to Hogan (T., p. 319), the function of a longitudinal rib, extending from one end to the other end of a horn for phonographs, was disclosed as follows (T., p. 320, lines 15-22).

"The trumpet is made of a sheet of tough paper or thin fibre, and each of the two edges of this material that come together when the sheet is folded to the cone form are first bordered by a thin *sheet-metal strip* folded longitudinally, as shown at *h* in Figure 5. *This metal strip encloses the sheet edge like a clip and extends from the large end to the point end.* The two metal strips are abutted together and joined by solder. *This metal strip not only serves as a means of joining the sheet edges, but also serves to augment and improve the sounding qualities of the trumpet*".

In French patent No. 321,507 of May 28, 1902, to Runge (T., pp. 393, 397) the function of a longitudinal rib extending from one end to the other end of a horn for phonographs was disclosed in the same manner. Runge added, however, that there might be "*two or more*" longitudinal ribs; that the ribs might be either upon the outside or upon the inside of the horn; and that the ribs not only served to join together the adjacent edges of the tapering strips composing the horn and to improve the sound-producing qualities of the horn, but also served to reinforce or strengthen the horn.

In Figs. 1 and 2 (T., p. 395) of his French patent, Runge shows a metal clip or strip G^1 , extending from one end to the other end of the horn, serving to join together the adjacent edges of the sheet material composing the horn. The metal clip or strip G^1 is exactly like that shown at h in Fig. 5 of Hogan's British patent of 1899 (T., p. 322). Runge points out that, in addition to the metal clip or strip G^1 , a second reinforcement, in the form of a fold or crease G^5 in the horn, may be employed. He adds, however, that the fold or crease G^5 may be eliminated and that two or more metal clips or strips G^1 may be employed. Runge says (T., p. 399):

"The second reinforcement, instead of being in the form of a crease, can take the form of a clip or metal strip fixed upon the exterior or the interior of the horn, and one can employ more than two reinforcements".

In claim 1 of his patent, Runge points out that two or more longitudinal metal strips or clips may be employed to improve the sound-producing qualities of the horn. Claim 1 reads as follows (T., p. 400):

"1st. In a graphophone or talking machine, a horn having two or more longitudinal reinforcements, serving to improve its sound-producing qualities".

U. S. patent No. 632,015 of August 29, 1899, to Hogan, makes the same disclosures (T., p. 275, lines 74-87).

Experts in this art, who have manufactured and used horns for phonographs from the beginning of the art down to the present day, agree, however, that Nielsen's claim that longitudinal ribs improve the sound-producing qualities of the horn is entirely without foundation (T., pp. 65, 83, 95-97, 111, 135-136).

Mr. Hawthorne says (T., p. 65):

“I have made a careful study of the construction and sound-producing qualities of horns for phonographs for nearly twenty years. It is my opinion, based upon many tests, and long experience, that there is no difference in the sound-producing qualities of a horn, whether of metal or other material, resulting from the use of one longitudinal rib and from the use of two or more longitudinal ribs”.

Mr. Stewart says (T., p. 83):

“I have had a wide experience with horns for phonographs, and my conclusion is that it is immaterial, so far as the sound-producing qualities of the horn are concerned, whether the horn is provided with one or two or more longitudinal ribs or seams or whether the seam is on the outside or on the inside”.

Mr. Senne says (T., pp. 135-136):

“I regard horns made of paper and other like material as superior to horns made of metal. The longitudinal ribs used by Nielsen are means merely for joining together the tapering strips of metal which make up the horn. *The ribs have no effect upon the sound-giving qualities of the horn.* They result merely from the mechanical construction of the horn, and so do the ribs formed in the construction of a paper horn from tapering strips of paper joined together at their edges. Horns made of paper or wood give clearer sounds than do metal horns. In constructing a horn from metal instead of from wood or paper, it was obvious in the art of making horns for phonographs that some appropriate means must be employed for joining together the edges of the tapering metal strips of which the horn was made. Hence solder or the lock seam or solder and the lock

seam have generally been employed for joining together the tapering strips of a metal horn. Strips of metal or of wood or of paper or other like material, either with or without an adhesive material such as glue, according to the necessities of the case, have been employed as obvious means for joining together the tapering strips of wood, paper, celluloid or other like material employed in the making of a phonograph horn. In each case, longitudinal ribs result from the mechanical construction of the horn, whether the horn be made of metal or other material”.

5. *The patents and publications, in evidence, of the prior art, and the affidavits of experts in the art prove that metal, wood, celluloid, cardboard, paper, leather and other like flexible sheet-material were known equivalents in the prior art for making the tapering strips with which to construct or build up horns for phonographs, in any form or shape desired.*

This fact is shown by Turpin’s French patent (T., pp. 383-386); by Cockman’s British patent (T., p. 362, line 32 to p. 363, line 7); by Villy’s British patent (p. 351, lines 4-6; p. 352, lines 25-29); and by the U. S., British and French patents heretofore referred to (*supra*, pp. 22-24).

In a book entitled “A Complete Manual of the Edison Phonograph”, published in 1897, it is said that wood, iron, steel, zinc, copper, brass, tin, aluminum, cornet metal, German silver, glass, hard rubber, papier-maché, and all sorts of material had been employed in the making of horns for phonographs (T., pp. 152-153).

The affidavits of experts in this art, who have manufactured and used horns for phonographs from the beginning of the art down to the present day, show

that the materials mentioned were known equivalents in the prior art in the construction or building up of horns for phonographs, from tapering strips joined together at their edges in a manner to form ribs upon the outside or upon the inside of the horn (T., pp. 64-67, 72, 88-89, 92-93, 98, 102, 105, 111-112, 121, 124-125, 135-136, 138-140).

6. *Even if metal had not been, as it was, the known equivalent, in the prior art, of wood, celluloid and other like flexible sheet-material, from which to make tapering strips for use in constructing or building up horns for phonographs, still the decided cases show that no patentable invention could have been involved in the substitution of metal for any other material in making such strips.*

This proposition is too well settled to require discussion. It has been held, for instance, in the following cases:

- New York Belting & Packing Co. v. Sierer*, 158 Fed., 819 (C. C. A.).
Brown v. Dist. of Columbia, 130 U. S., 87.
Hicks v. Kelsey, 18 Wall., 670.
Hotchkiss v. Greenwood, 11 How., 248.
Cover v. American Co., 188 Fed., 670 (C. C.).

In the *New York Belting & Packing Co.* case it is held, as stated in the head note (158 Fed., 819):

“The Funes’s patent No. 527,961 for a tile floor or wall composed of tiles of yielding material with interlocking joints is void for lack of invention in view of the prior art which showed interlocking wall tiles of non-yielding material, and floor tiles of rubber not interlocking”.

In *Hicks v. Kelsey* (18 Wall., 670, 674), Mr. Justice Bradley pointed out that the Supreme Court had held that the substitution of porcelain for metal in making door-knobs of a peculiar construction was not patentable, though the new material was better adapted to the purpose and made a better and cheaper knob—having been used for door knobs, however, before. Accordingly it was held that evidence, tending to show that the *iron* wagon-reach of the plaintiff was a better reach, requiring less repair and having greater solidity than the *wooden* reach of the prior art, was not sufficient to show invention which rested upon a mere change of material—making the curve of iron instead of wood and iron.

THE CLAIMS OF THE NIELSEN PATENT IN SUIT ARE ANTICIPATED AND VOID BY REASON OF THE PRIOR USES SHOWN BY THE AFFIDAVITS OF HAWTHORNE, GEORGE AND STEWART (T., pp. 57-74, 75-77, 78-83).

These three affidavits show that, prior to the year 1900, the firm of Hawthorne & Sheble made and sold at Philadelphia, Pa., horns for phonographs and similar machines, embodying, in combination, all the features of the claims and specification of the Nielsen patent in suit, except that Hawthorne & Sheble employed the lock seam, used in defendant's horns, while Nielsen employed the outwardly-directed flanges or the butt seam of the McVeety & Ford patents (T., pp. 235, 294).

In other words, Hawthorne & Sheble made horns, of the shape and construction of the Nielsen horn, except as to the kind of seam employed, in precisely the manner shown in Gersdorff's United States patent No. 491,421 of February 7, 1893, for a funnel or horn (T., p. 258; *supra*, pp. 48-51). Gersdorff says that he made his funnel or horn from two or more—preferably three—tapering strips of metal (which were neces-

sarily curved along their sides), joined together at their edges by lock seams, forming longitudinal ribs, to strengthen the horn, extending from one end of the horn to the other. Hawthorne & Sheble employed four, five or six of such tapering strips of metal so joined together.

Mr. Hawthorne has annexed to his affidavit diagrams Nos. 1, 2, 3 and 4 (T., p. 71) to show the shape and method of construction of horns made by Hawthorne & Sheble prior to 1900. It appears that the shape of the horn shown in diagram No. 2 is precisely the shape of Gersdorff's funnel shown in Fig. 2 of his patent (T., p. 258) and precisely the bell-shaped horn shown in Fig 1 of the Nielsen patent (T., p. 28).

Messrs. Hawthorne, George and Stewart made and sold these horns. They made them according to the well-known methods practised in the art prior to the year 1900. There can be no question as to the correctness of their description (*American Co. v. Weston*, 59 Fed., 147), for what they did was merely in accordance with common knowledge existing in the art as shown by the Gersdorff, Turpin, Villy and other patents and publications produced by defendant.

It will suffice to describe two of the different kinds of horns manufactured by Hawthorne & Sheble, prior to the year 1900, from tapering strips of metal joined together at their edges by lock seams forming longitudinal ribs extending from one end of the horn to the other. The shape of one of these horns, 56 inches in length, is shown in diagram No. 1 (T., p. 71). Describing this horn Mr. Hawthorne says (T., p. 59):

“The tapering strips of which these horns were made by me and my said firm, Hawthorne and Sheble, during the years 1895-1899, inclusive, were so shaped and joined together at

their edges by the tinsmith's or lock seam afore-said that the horns were *bell-shaped, being very narrow at the small end and very wide and flaring at the large end*".

Another horn manufactured by Hawthorne & Sheble prior to 1900, from tapering strips of metal joined together at their edges by lock seams forming longitudinal ribs extending from one end of the horn to the other is shown in diagram No. 2 (T., p. 71). This horn was 36 inches long and 36 inches wide at the bell. Describing this horn Mr. Hawthorne says (T., pp. 60-61):

"In 1898-1899 I bought the first Graphophone Grand talking machine put out by the American Graphophone Company, paying about five hundred dollars (\$500.00) for it, and at that time and before 1900 I made horns for use with said Graphophone Grand talking machines. These horns were made in the manner described above. They were built up of tapering strips of metal extending from one end of the horn to the other, joined together at their edges by the tinsmith's or lock seam. Four or five of such tapering strips of metal were used in the construction of each horn. These horns were thirty-six inches long and had an opening at the large end of the horn thirty-six inches in diameter, *the large end of the horn flaring and the horn being bell-shaped*".

In 1899 Hawthorne & Sheble made two large horns, about fourteen feet long, for the United States Navy, according to the same method. Describing these large horns, Mr. Hawthorne says (T., p. 61):

"In 1898, at the time of the Spanish-American war, I and my said firm made two large

horns or megaphones which, as I was informed, were intended for use on two of the United States battleships, the Iowa and the Oregon, according to my present recollection of the names of these battleships. These two large horns or megaphones were each about fourteen feet long. They were made in the manner above described, consisting of five or six tapering sheets of metal extending from one end of the horn to the other and joined together at their edges by the tinsmith's or lock seams forming longitudinal ribs extending from one end of the horn to the other. The only difference between these two large horns or megaphones and the other horns composed of several tapering strips, above described, was that the two megaphones were of greater size".

Mr. George entered the employ of Hawthorne & Sheble in 1898 and made these horns for Hawthorne & Sheble prior to the year 1900. He corroborates Mr. Hawthorne (T., pp. 75-77).

Mr. Stewart became connected with the firm of Hawthorne & Sheble in 1894 and continued with that firm until 1908. Mr. Stewart corroborates Mr. Hawthorne.

Mr. Hawthorne explains, what will be obvious to the court, that it was necessary to cut the sheet-metal into several tapering strips in order to construct a large horn in an economical and commercial manner (T., p. 70). Mr. Stewart testifies to the same effect (T., p. 79).

Mr. Hawthorne has produced a metal horn of another style, made by him prior to 1900, and has annexed a photograph thereof to his affidavit (T., p. 72). This horn is a complete anticipation of each of the three claims of the Nielsen patent in suit, except that the five metal strips composing this horn are provided at their

edges with longitudinal *inwardly-directed* instead of outwardly-directed flanges, forming butt seams like Nielsen's butt seams. The teachings of the prior art, as shown by the patents presented by defendant, show that it is entirely immaterial whether the ribs are on the inside of the horn, as is the case with this Hawthorne & Sheble horn of the prior art, or are on the outside of the horn, as set forth in the claims of the Nielsen patent in suit. The French patent to Turpin No. 318,742 of February 7, 1902, states (T., p. 389, par. 3), that the ribs shown in Figs. 8, 9, 10, 12 and 13 (T., pp. 380-381), may be either of *metal* or of *wood* and may be either on the *outside* or on the *inside* of the horn. Certainly, then, it involved no invention on Nielsen's part to form his longitudinal ribs on the outside instead of on the inside of the horn.

Innumerable patents of the prior art show ribs both upon the inside and upon the outside of the horn (*supra*, pp. 65-67). The lock seams employed in defendant's Edison horns in reality form longitudinal ribs both upon the inside and upon the outside of the horn.

Annexed to the affidavit of Mr. Hawthorne is a photograph (T., p. 73) of a circular issued in 1900, showing glass horns for phonographs, made and sold by the firm of Hawthorne & Sheble and by its successor, the Hawthorne & Sheble Mfg. Co. These glass horns were bell shaped and represented flower or morning-glory horns. Of course, as shown above (*supra*, pp. 64-65), Nielsen was not the originator of the bell-shaped or flower-shaped horn. This appears also from the photograph referred to.

PLAINTIFF HAS BEEN GUILTY OF SUCH LACHES, FROM OCTOBER, 1904, TO MAY, 1911, THAT THE MOTION FOR PRELIMINARY INJUNCTION SHOULD HAVE BEEN DENIED, AND THE SUIT DISMISSED.

Complainant's laches appears from the affidavits of Hawthorne, Senne, Pommer, Bacigalupi, Bacigalupi, Jr., Abbott, and Baley (T., pp. 68-69, 130-149, 197-199, 200-202, 203-204, 205, 206-208); also from the testimony of Krabbe and Locke in the action at law against Sherman, Clay & Co. (T., p. 192; and Transcript in No. 2306, pp. 46-48, 67-68, 80-81, 87-88).

The affidavits show that plaintiff and its predecessors in title stood by from October, 1904, when the Nielsen patent was issued, to May, 1911, when the action at law against Sherman, Clay & Co. was begun, without ever having brought suit charging that horns like defendants' horns, made of metal strips joined together by the tinsmith's or lock seam, were an infringement. They permitted others during all this time to build up a business in the manufacture and sale of such horns, in the *Eastern part* of the United States. Now, at this late date, in a speculative suit, brought in a foreign jurisdiction in the far West against a mere dealer in horns of eastern manufacture, they seek an injunction and a recovery of profits and damages for what they themselves have permitted for so many years. The attempt is *unconscionable on its face* and should not be countenanced in a Court of Equity.

Mr. Hawthorne says (T., pp. 68-69), that on February 10, 1906, he refused to enter into any agreement with the owners of the Nielsen patent, who were represented by Mr. Locke, who makes an affidavit on behalf of plaintiff. Mr. Hawthorne also produces an advertisement showing one of the horns made by him, which plaintiff *now* alleges is an infringement of the

Nielsen patent, and annexes a photograph thereof to his affidavit (T., p. 74). This advertisement appeared in the *first* number of the "Talking Machine World", published January 15, 1905 (T., p. 69). It appears, therefore, that for more than eight years, to the knowledge of the owners of the Nielsen patent, horns which they now allege to be infringements of the patent were upon the market and that the manufacturers thereof refused to acknowledge the validity of the Nielsen patent or to enter into any arrangement with regard thereto.

The affidavit of Mr. Senne (T., pp. 130-149), supported by the affidavit of Mr. Hicks (T., pp. 150-152, 158-161), shows the same state of affairs. The owners of the Nielsen patent, having obtained an injunction against Senne and his partner *by default*, because they (Senne and his partner) could not afford to litigate the suit, claimed that Senne's *paper* horns were an infringement of the Nielsen patent; but Senne went on manufacturing the paper horns; and nothing was ever done by the owners of the Nielsen patent. Before the beginning of the suit, Senne and his partner had been manufacturing metal-strip horns provided with the *outwardly-directed flanges* of the Nielsen patent.

Mr. Senne shows, in his affidavit (T., p. 134), that Mr. Krabbe, representing the owner of the Nielsen patent, told him that "*they did not want to make money by making and selling horns but wanted to make money out of others who were making and selling horns through suits based upon the Nielsen patent and by requiring manufacturers of horns to pay a royalty under the patent*" (T., p. 134). That is what they attempted to do with Senne in 1905. That is what they attempted to do with Hawthorne in 1906. That is what they have attempted to do, as appears from plaintiff's affidavits, with the Edison Companies,

The National Phonograph Company and Thomas A. Edison, Inc. (T., pp. 16, 22). And that has been the course of procedure of the owners of the Nielsen patent from the time of its issue down to the present day. They now make claims under the patent; but they never brought a suit to enforce the claims now made until May, 1911. They stood by for years knowing that manufacturers and dealers throughout the country were making and selling these horns of metal strips, joined together by the lock seam, as in defendant's horns and in the prior art. And when they did bring a suit they did not bring it in the East, where knowledge of horns for phonographs exists, but they came to the extreme West of the United States, where they knew that evidence against the patent would be most difficult to obtain, after the lapse of so many years. It is certainly remarkable that complainant, a New York corporation, should bring suit in California, claiming that horns sold by a New Jersey corporation are an infringement of the Nielsen patent.

Plaintiff has waited and relied upon the lapse of time in the hope that at this late date it would not be possible to show the fact that defendant's horns were made and sold in this country before the date of Nielsen's alleged invention.

In *Woodmanse Co. v. Williams*, 68 Fed. 489, 493 (C. C. A.), Judge LURTON said:

"One who invokes the protection of equity must be 'prompt, eager, and ready' in the enforcement of his rights. Equity will not encourage a suitor who has long slept over his rights. It was well observed by Judge Coxe, in Kittle v. Hall, 29 Fed. 511, that 'time passes, memory fails, witnesses die, proof is lost, and the rights of individuals and of the public intervene. Long acquiescence and laches can only be excused by proof showing excusable ignorance, or positive

inability to proceed on the part of the complainant, or that he is the victim of fraud or concealment on the part of others.' He adds 'that the court will not entertain a case when it appears that the complainant, or those to whose rights he has succeeded, have acquiesced for a long term of years in the infringement of the exclusive right conferred by the patent, or have delayed, without legal excuse, the prosecution of those who have openly violated it.'—These general principles find ample support in many cases, only a few of which need be cited" (citing cases).

Upon the question of laches what has been said above, is corroborated by the testimony in the prior action at law. Mr. Krabbe and Mr. Locke, testifying on behalf of the plaintiff, stated that both before and after Nielsen filed his application for the patent in suit, others were for years constantly making and selling, in this country, horns now claimed to infringe the patent (T., p. 192; and Transcript in No. 2306, pp. 46-48, 67-68, 80-81, 87-88). No suit was brought, however, to enjoin the making of such horns. No defense of *laches* was or could be raised in the prior action *at law*. It is raised in the suit at bar with new evidence from Messrs. Hawthorne and Senne, *et al.* No more complete showing of laches could possibly be made. Mr. Locke confirms the statement of Mr. Hawthorne with respect to what passed between them in 1906 with regard to the Nielsen patent (T., p. 192; and Transcript in No. 2306, p. 80).

The following cases show that by reason of the laches of the owners of the Nielsen patent, the motion for preliminary injunction should have been denied and that no relief should be granted to plaintiff, even on final hearing (*McGill v. Whitehead Co.*, 137 Fed., 97; *Woodmanse Co. v. Williams*, 68 Fed., 489, 492-494; *Richardson v. Osborne Co.*, 93 Fed., 828; *Richardson*

v. *Osborne Co.*, 82 Fed., 95; *Owen v. Ladd*, 76 Fed., 992; *Meyrowitz Co. v. Eccleston*, 98 Fed., 437; *Edison Company v. Equitable Society*, 55 Fed., 478). Unfair competition cases, based on deception of the public, are, of course, not in point.

The cases cited above show that the present owner of the Nielsen patent is bound by the actions of its predecessors in title (*Woodmanse Co. v. Williams*, 68 Fed., 489, 492, for instance). The attempt made, in the moving affidavits (T., pp. 13-26) upon the motion, to excuse complainant's laches is futile. The attempt shows that complainant is fully conscious of its laches. The fact that Mr. Locke suppresses facts well known to him thoroughly discredits the attempt, for it was Mr. Locke who called on Mr. Hawthorne in 1906, and it was Mr. Locke to whom Mr. Hawthorne refused to acknowledge the validity of the Nielsen patent. The explanation given by Mr. Locke of what the complainant has recently been doing in California is of little moment. In 1905 and 1906 and prior thereto Mr. Krabbe and Mr. Locke knew that manufacturers of horns in the East defied the Nielsen patent, and from that time to this manufacturers and dealers throughout the United States have relied upon the fact that no suit was brought against them upon the Nielsen patent. The bringing of the suit against Sherman, Clay & Co. in California, thousands of miles distant from the seat of phonograph operations, and as late as 1911, only goes to show that the owners of the Nielsen patent, including Mr. Locke, recognized its invalidity, never seriously believed that defendant's horns infringed, and slept on their rights now alleged, until they thought of attempting to sustain the Nielsen patent in an action at law, before a jury, brought in the far West on a stale claim against a mere dealer. The bill is clearly without equity and should be dismissed.

The defense of laches need not be pleaded (*Woodmanse Co. v. Williams*, 68 Fed., 489, 494; *Richards v. Mackall*, 124 U. S., 183; *Sullivan v. Portland Co.*, 94 U. S., 806; Walker, Pat. § 597). The burden is on plaintiff to excuse it.

DEFENDANT'S HORNS DO NOT INFRINGE ANY OF THE THREE CLAIMS OF THE NIELSEN PATENT IN SUIT, IF ANY OF THOSE CLAIMS ARE VALID WHEN PROPERLY CONSTRUED. THE DECIDED CASES HOLD THAT WHEN A CLAIM IS EXPLICIT THE COURTS CANNOT ALTER OR ENLARGE IT, EVEN THOUGH THE PATENTEE MAY NOT HAVE CLAIMED THE WHOLE OF HIS INVENTION. HENCE THE CLAIMS OF THE NIELSEN PATENT IN SUIT MUST BE LIMITED BY THE OUTWARDLY-DIRECTED FLANGES, IN WHICH CASE DEFENDANT DOES NOT INFRINGE, ASSUMING, FOR THE SAKE OF ARGUMENT, THAT ANY OF THE CLAIMS ARE VALID.

In *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U. S., 274, 278, the patentees limited their claim to "wide and thin" bars. The Court held that since the defendant used "round or cylindrical" bars the defendant did not infringe the claim of the patent, stating that when a claim is so explicit, the Courts cannot alter or enlarge it, even though the patentee may not have claimed the whole of his invention, his remedy, if any, being by reissue, citing *Merrill v. Yeomans*, 94 U. S., 568.

The decided cases are all to the same effect. It will suffice to cite the following:

McLean v. Ortmyer, 141 U. S., 419,
424.

Coupe v. Royer, 155 U. S., 565, 575-577.

McCarty v. Railroad Co., 160 U. S., 110,
116.

Cimiotti Co. v. American Co., 198 U. S.,
399, 410.

Morse Chain Co. v. Link-belt Co., 189
Fed., 584, 588 (C. C. A.).

*General Electric Co. v. Allis-Chalmers
Co.*, 199 Fed., 169, 178.

Loraine Co. v. General Electric Co., 198
Fed., 100, 106.

Sharpe v. Bellinger, 168 Fed., 295, 303.

In *Coupe v. Royer, supra*, the Supreme Court held that a claim for a "vertical shaft" was not infringed by a "horizontal shaft", and reversed the Circuit Court because in its charge to the jury it did not restrict the claim to a "vertical shaft" (155 U. S., 565, 575-577).

In *Morse Chain Co. v. Link-Belt Co.*, 189 Fed., 584, 588, cited *supra*, the Circuit Court of Appeals said:

"Of the claims in controversy the sixth and ninth are expressly limited to a two-part pintle. The tenth is so limited by implication as it provides for 'pintles formed in separate parts which bear upon each other,' which, in view of the context, can mean a two-part pintle only. Even if the reissue were valid these claims would not be infringed. *A patentee who limits his claims to the precise construction shown and described, even though not obliged to do so, cannot hold as an infringer one who uses a different construction.* The new claim, the twelfth, if valid, is probably infringed, as it provides for 'pintles formed in a plurality of separate parts.' *If, however, it be construed to cover a three-part pintle, it is void, as no such structure is described or claimed in the original*".

In the Court below plaintiff contended that defendant's two Edison metal strip horns infringed claims 2

and 3 of the Nielsen patent in suit. These horns are known as "the Edison straight metal horn" and "the Edison Cygnet metal horn".

The Edison straight metal horn is precisely like the horn of Fig. 5 of the Villy British patent (T., p. 354). Villy stated that he made his horn of suitable flexible sheet material (*supra*, pp. 43-45). The Edison straight metal horn is made of such material, to-wit, metal.

The Edison Cygnet metal horn is like the Edison straight horn except that the long curved funnel, like the neck of a swan, is substituted in the Cygnet horn for the straight funnel or stem employed in the Edison straight metal horn.

It is obvious that the stems or funnels at the small ends of the Edison metal horns are in themselves complete horns for the reproduction of sound from a phonograph record. These stems or funnels are made of a single piece of sheet metal. The bells of the Edison metal horns are made of a number of sections precisely like the sections of the horn of the Villy British patent (See Fig. 8 of the Villy patent, T., p. 355).

The Edison horns employ the tinsmith's or the lock seam of the prior art. It is the seam shown in the horn or funnel of the Gersdorff patent, No. 491,421 of Feb. 7, 1893 (T., p. 258, Fig. 2).

The Court will observe that the Edison metal horns do not employ the longitudinal ribs b^2 of the Nielsen patent, formed as shown in Fig. 3 of the Nielsen patent, by joining together two outwardly-directed flanges b^3 .

As heretofore shown, Nielsen believed that these outwardly-directed flanges would give strength and rigidity to the horn and improve the sound-producing qualities of the horn, and it is apparent that the ribs b^2 formed from such outwardly-directed flanges b^3 will afford greater resistance and greater rigidity than a seam or rib composed of flat metal like defendant's lock

seam of the prior art. However, Nielsen's horn was an impractical horn, by reason of the attempt to join together the tapering sections of the horn by means of such outwardly-directed flanges. When one considers the mechanical difficulties involved in attempting to hold such flanges together while soldering, it is easy to understand that *the horn of the Nielsen patent in suit never went into use*. Plaintiff's claim that the flower horn of the art is the Nielsen horn is preposterous. Other manufacturers developed the flower horn with the lock seam, and Nielsen never brought suit to enjoin the manufacture and sale of any such horn until the action at law was brought against Sherman, Clay & Co. in May, 1911, after the lapse of many years from the date of the issue of the Nielsen patent, October 4, 1904.

It is clear that, if Nielsen made any invention at all, his invention was an extremely narrow one. Having limited his claims by specific words to a specific form of device, to-wit, strips "provided at their edges with longitudinal outwardly-directed flanges whereby the body portion of the horn is provided on the outside thereof with longitudinally-arranged ribs", he is bound thereby. Such is the limitation of claims 1 and 2; and, as heretofore shown, claim 3, if valid from any conceivable point of view, must be likewise limited, or held invalid.

IT IS WELL SETTLED THAT THE DISTINCTION BETWEEN TWO CLAIMS OF A PATENT MUST BE MAINTAINED. HENCE, CLAIM 2 MUST BE DIFFERENTIATED FROM CLAIM 3. THIS CAN BE DONE ONLY BY LIMITING CLAIM 2 TO "STRIPS OF METAL PROVIDED AT THEIR EDGES WITH LONGITUDINAL OUTWARDLY-DIRECTED FLANGES WHEREBY THE BODY PORTION OF THE HORN IS PROVIDED ON THE OUTSIDE THEREOF WITH LONGITUDINALLY-ARRANGED

RIBS." SINCE DEFENDANT'S HORNS EMPLOY THE LOCK SEAM OF THE PRIOR ART AND DO NOT EMPLOY THE OUTWARDLY-DIRECTED FLANGES, DEFENDANT DOES NOT INFRINGE CLAIM 2. CLAIM 3 BEING CLEARLY INVALID, AS SHOWN ABOVE (SUPRA, PP. 21-35, 36-63), DEFENDANT DOES NOT INFRINGE, AND THE BILL SHOULD BE DISMISSED.

In *National Co. v. American Co.*, 53 Fed., 367, 370 (C. C. A.) the Court said:

"There is nothing upon this record which would warrant us in attributing to the patentee the folly of having presented, and to the patent office the improvidence of having allowed, two claims for the same thing. The distinction between them must be maintained, that both may be given effect."

It has been shown that the only distinction between claim 2 and claim 3 is the limitation in claim 2 that the strips are provided at their edges with the longitudinal outwardly-directed flanges, by the union of which the body portion of the horn is provided on the outside thereof with the longitudinally-arranged ribs b^2 (*supra* pp. 12-14).

That this distinction between claims 2 and 3 must be maintained is well settled by the following cases, in addition to the case above cited:

Metallic Co. v. Brown, 110 Fed., 665, 668 (C. C. A.); *Boyer v. Keller Tool Co.*, 127 Fed., 130, 134 (C. C. A.); *Diamond Co. v. Ruby Co.*, 127 Fed., 341, 345 (C. C.); *Marshall v. Pettingell-Andrews Co.*, 164 Fed., 862, 867 (C. C. A.); *Excelsior Drum Works v. Sheip & Vandegrift*, 180 Fed., 980, 982 (C. C. A.); *General Electric Co. v. Freeman Co.*, 190 Fed., 34, 36 (C. C.); *aff'd* 191 Fed., 168 (C. C. A.).

WHERE, AS HERE, A PATENT IS VOID FOR LACK OF INVENTION IN VIEW OF THE PRIOR ART, EXTENSIVE SALES OF THE PATENTED ARTICLE ARE IMMATERIAL WITHIN THE DECISIONS OF THE COURTS.

This proposition has been held in numerous cases. It will suffice to cite the following:

McLean v. Ortmyer, 141 U. S., 419, 428; *Voightmann v. Weis Co.*, 148 Fed., 848, 853-854 (C. C. A.).

THE HORN OF THE NIELSEN PATENT IN SUIT, COMPOSED OF STRIPS SECURED TOGETHER AT THEIR EDGES BY OUTWARDLY-DIRECTED FLANGES, WAS AN IMPRACTICAL CONSTRUCTION. IT NEVER WENT INTO USE. AS SHOWN, DEFENDANT'S HORNS WITH THE LOCK SEAM WERE CONSTRUCTED IN ACCORDANCE WITH THE HORNS OF THE PRIOR ART. THE ADVERTISEMENTS OF THE NATIONAL PHONOGRAPH COMPANY IN THE TALKING MACHINE WORLD FOR DECEMBER 15, 1907, AND JANUARY, FEBRUARY AND MARCH 15, 1908, WERE PRESENTED BY PLAINTIFF, WITHOUT NOTICE, ON THE ARGUMENT. THOSE ADVERTISEMENTS MERELY SET FORTH THAT THE NATIONAL PHONOGRAPH COMPANY WOULD THEREAFTER SUPPLY WELL-CONSTRUCTED HORNS WITH ITS PHONOGRAPHS, AS DISTINGUISHED FROM POORLY-CONSTRUCTED HORNS THERETOFORE SUPPLIED BY OTHERS FOR USE WITH ITS PHONOGRAPHS. THESE ADVERTISEMENTS ARE IN NO WAY BINDING ON DEFENDANT.

Prior to December, 1907, the National Phonograph Company did not supply horns with its phonographs, except a very small horn ten or fourteen inches in length. The reproducing horns were supplied to users of the phonograph by jobbers and dealers who secured the horns from the manufacturers. The evidence shows that the defendant's horns had been upon the market for several years prior to December, 1907, when the

National Phonograph Company, finding that such horns of inferior manufacture had been supplied to the public by others for use with its phonographs, undertook to supply with its phonographs horns properly constructed. This marked a change of policy on the part of the National Phonograph Company, for the reason stated.

Appellant's counsel will not comment on the fact that plaintiff's counsel produced these advertisements, without notice, upon the oral argument of the motion. The advertisements are not the advertisements of the defendant, and they have no bearing whatever on the issues involved in this case.

WHERE, AS HERE, IT APPEARS THAT THE COURT BELOW HAS EXERCISED ITS DISCRETION BY GRNTING A MOTION FOR PRELIMINARY INJUNCTION UPON A WHOLLY WRONG COMPREHENSION OF THE FACTS AND OF THE LAW OF THE CASE, THE CIRCUIT COURT OF APPEALS WILL REVERSE. SO ALSO WHERE, AS HERE, NEW EVIDENCE IS INTRODUCED, OF SUCH CHARACTER THAT IF IT HAD BEEN PRESENTED IN THE FORMER CASE IT WOULD PROBABLY HAVE LED TO A DIFFERENT CONCLUSION, THE CIRCUIT COURT OF APPEALS WILL REVERSE. INDEED, IN SUCH CASES, THE CIRCUIT COURT OF APPEALS WILL, AT TIMES, DISMISS THE BILL FOR WANT OF EQUITY WITHOUT COMPELLING THE PARTIES TO INCUR THE EXPENSE OF A FINAL HEARING.

These propositions are well established by the following cases:

Welsbach Light Co. v. Cosmopolitan Co., 104 Fed., 83 (C. C. A.); *Diamond Co. v. Union Co.*, 129 Fed., 602; *Calculagraph Co. v. Automatic Co.*, 149 Fed., 436; *Westinghouse Co. v. Condit Co.*, 159 Fed., 144; *Western Co. v. Keystone Co.*, 115 Fed., 809; *General Co. v. Condit Co.*, 191 Fed., 511; *Interurban Co. v.*

Westinghouse Co., 186 Fed., 166, 170; *Kings Co. v. United States Co.*, 182 Fed., 59, 61 (C. C. A., 9th C.).

In the following cases the appellate courts have held that, in a proper case, upon a motion for preliminary injunction, the bill can be dismissed for want of equity, either in the court below or in the appellate court.

Harriman v. Northern Securities Co., 197 U. S., 244, 286; *Castner v. Coffman*, 178 U. S., 168; *Mast, Foos & Co. v. Stover Mfg. Co.*, 177 U. S., 486, and 89 Fed., 333, 337; *De Laval Co. v. Vermont Co.*, 109 Fed., 813; *Street v. American Co.*, 115 Fed., 634.

In *General Electric Co. v. Condit Co.*, 191 Fed., 511, 513, it was held as follows:

“Where, in a suit for infringement, although the patent has been adjudged valid in a prior suit, an entirely new issue as to anticipation is raised and supported by testimony which is convincing if credited, unless such testimony is clearly impeached by complainant, his rights is too doubtful to warrant the granting of a preliminary injunction”.

THE DECIDED CASES SHOW THAT THE BILL OF COMPLAINT SHOULD BE DISMISSED UPON THE HEARING OF THIS APPEAL, FOR THE REASON THAT IT CLEARLY APPEARS: FIRST, THAT THE NIELSEN PATENT IN SUIT IS INVALID; AND, SECOND, THAT DEFENDANT DOES NOT INFRINGE.

The following cases show that this Court has power to dismiss the bill of complaint upon the hearing of this appeal:

Harriman v. Northern Securities Co., 197 U. S., 244, 286; *Castner v. Coffman*, 178 U. S., 168; *Mast, Foos & Co. v. Stover Mfg. Co.*, 177 U. S., 486 and 89

Fed., 333, 337; *De Laval Co. v. Vermont Co.*, 109 Fed., 813; *Streat v. American Co.*, 115 Fed., 634; see also, *Sheffield Car Co. v. D'Arcy*, 194 Fed., 686, 694.

The Court can clearly see from the record now before it that the claims of the Nielsen patent in suit are anticipated and void; and that even if claims 1 and 2 can be differentiated from the prior art by limiting them to longitudinally-arranged strips provided at their edges with longitudinal outwardly-directed flanges, defendant does not infringe. Plaintiff is a New York corporation. The horns charged with infringement are alleged to have been originally sold by a New Jersey corporation. Either New York or New Jersey would be the natural place to litigate the questions here involved. The expense of carrying on these suits in California will necessarily be large because the witnesses having knowledge of the facts reside in the East. Aside from the uses of the prior art, the patents and publications of the prior art conclusively show the invalidity of all the claims of the Nielsen patent. For the reasons stated the bill of complaint should be dismissed.

PLAINTIFF DOES NOT SHOW THAT DEFENDANT SOLD HORNS FOR PHONOGRAPHS IN INFRINGEMENT OF THE NEILSEN PATENT IN SUIT.

In discussing this point, reference will be made only to the question as to whether or not the horns sold by the defendant were horns put upon the market by the authority of the plaintiff.

The notice of motion set forth that plaintiff would rely upon the record in the prior action at law and suit in equity against Sherman, Clay & Co. In that action at law Mr. William Locke, Jr., testified that in May, 1908, the plaintiff turned over its horn business to the Stand-

ard Metal Manufacturing Company of New Jersey, upon an agreement for payment of royalty by the Standard Metal Manufacturing Company to plaintiff for horns made and sold (T., pp. 189-191; Transcript in No. 2306, pp. 80-87). Mr. Locke makes substantially the same statement in his affidavits upon this motion (T., p. 15). When testifying in the action at law, Mr. Locke said that the Standard Metal Manufacturing Company was the largest manufacturer of talking machine horns in the country and that it manufactured the bulk of the horns for the Edison Phonograph Company (T., p. 190; Transcript in No. 2306, p. 83). He stated that the plaintiff ceased to do business in May, 1908, and that "the whole matter had been turned over to the Standard Metal Manufacturing Company under the terms which you have stated" (T., p. 190; Transcript in No. 2306, pp. 83, 81-82).

The charge of infringement is that defendant is engaged in the sale of horns purchased from the Edison Company, but the proofs show that plaintiff turned over its business to the Standard Metal Manufacturing Company and that the Standard Metal Manufacturing Company supplies the Edison Company with the horns purchased by defendant. Such being the facts, there is no proof of infringement.

Plaintiff's folding horns were put out under the Nielsen patent in suit as well as under the Villy re-issue patent (Transcript No. 2306, pp. 89-90). It is very clear, from the evidence referred to, that plaintiff authorized the Standard Metal Manufacturing Company to make and sell horns under the Nielsen patent. From the fact that no suit was ever brought against that company, plaintiff led the public to believe that such was the case and is now estopped to assert the contrary.

CONCLUSION.

For the reasons stated it is respectfully submitted that the order granting the motion for an injunction *pendente lite* should be reversed, with costs, with directions to dismiss the bill.

Respectfully submitted,

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